

## **II. REMARKS**

### **A. Introduction**

The Examiner's prior Office action mailed July 30, 2002 ("Prior Office action") rejected all of applicants' claims under 35 U.S.C. § 112, first paragraph, for lack of written description support. The Prior Office action also rejected applicants' claim of priority under § 120 to the filing date of applicants' parent application for all of the pending claims and applied numerous intervening references against applicants' pending claims.

In response to these rejections, applicants explained in detail their position, and the legal bases thereof, regarding their compliance with §§ 112 and 120. *See* applicants' January 29, 2003, Amendment and Request for Reconsideration ("January 2003 Response"). Applicants also submitted an expert declaration of Dr. George T. Ligler ("Ligler Declaration") demonstrating how each and every claim, as amended, was supported under the requirements of § 112, first paragraph, in both applicants' 1981 and 1987 specifications.

In the Office action, the Examiner has withdrawn all of the § 112, first paragraph, rejections asserted in the Prior Office action. Accordingly, applicants have effectively overcome the § 112, first paragraph, rejections asserted in the Prior Office action. In the instant Office action, the Examiner makes one new § 112, first paragraph, rejection, based on the claim recitation of "determining content" (or similar "content" limitations), which is applied against all of the pending claims. But for this rejection to this one claim recitation, applicants understand that the Examiner does not object to applicants' position that each and every pending claim is fully supported under § 112, first paragraph, by applicants' instant 1987 specification.

In the Office action, the Examiner also has withdrawn all of the rejections asserted in the Prior Office action based on intervening references under 35 U.S.C. §§ 102 and 103. Accordingly, applicants have effectively overcome the §§ 102 and 103 rejections based on the intervening references applied in the Prior Office action. In the instant Office action, the Examiner applies only one intervening reference in a § 103 rejection against claims 2, 3, 4, 7, 10, 13-15 and 17. Accordingly, the issue of whether applicants' claims are entitled to priority under

§ 120 is moot with respect to claims 5, 8, 9, 12, 16, 20-30, 33-42 and 67-104. *See* Office action p. 57 (“The examiner understands that applicants’ claim to the 1981 priority date needs only be addressed and resolved for those claims which are properly rejected under sections 102 and 103 via intervening prior art. Thus when applicant elects to amend the claims to overcome the intervening prior art, the section 120 priority issue becomes moot.”). Further, as the Examiner only objects to an alleged lack of written description support for the claim recitation “determining content” (or similar “content” limitations), applicants understand that there is now only one issue regarding written description support under § 112, first paragraph with respect to applicants’ 1987 specification.

**B. Response To § 120 Issues**

**1. Response to The Examiner’s General Discussion Of § 120 Issues**

Notwithstanding the fact that the Examiner and applicants agree that the § 120 priority issue is relevant only with respect to the intervening reference applied against claims 2, 3, 4, 7, 10, 13-15 and 17, several sections of the Office action are devoted to a generic discussion of § 120 priority issues. *See* Office action Sections A, B, D, E1, and Appendices I-V. As the § 120 issue is now limited to the subject matter of a single independent claim (claim 2) and eight claims depending from claim 2, there is no reason to address the application of § 120 in the abstract or hypothetically as the Examiner has in great length in the Office action. Applicants maintain that they have accurately and comprehensively set forth the requirements of § 120 in their prior filings including the January 2003 response. Further, applicants have demonstrated support in both the instant specification and the 1981 specification for the subject matter of claims 2, 3, 4, 7, 10, 13-15 and 17. Accordingly, applicants do not address the abstract and hypothetical examples of the application of § 120 contained in the Office action. Applicants do not concede that the abstract and hypothetical examples in the Office action are correct. Rather, applicants assert that there is no showing that claims 2, 3, 4, 7, 10, 13-15 and 17 are not entitled

to the benefit of the November 3, 1981, filing date under § 120. Applicants reserve their right to fully address and respond to any argument, assertion, issue contained in Sections A, B, D, E1, and Appendices I-V of the Office action, if and when any such issue, argument or assertion is applied against claimed subject matter.

The Ligler Declaration, filed with the January 2003 Response, demonstrates that both the 1981 specification and the 1987 specification contain a written description of the subject matter of claim 2 (and claims 3, 4, 7, 10, 13-15 and 17 depending therefrom). In paragraph 21 of his declaration, Dr. Ligler identifies support for each limitation of claim 2 in both specifications. In paragraphs 22-26, Dr. Ligler explains how the disclosures of both specifications support the subject matter of claim 2. In paragraph 26, Dr. Ligler opines “that the claimed subject matter of . . . claim 2 is disclosed in sufficient detail, in both the 1981 and 1987 specifications, that a person of ordinary skill in the relevant time frames would reasonably understand that the inventor possessed the subject matter of amended claim 2 at the time of the filing of those specifications.” In paragraph 42, Dr. Ligler also opined that the subject matter of claims 3, 4, 7, 10, 13-15 and 17 is sufficiently described in both the 1981 and 1987 specifications based on the support identified at Tab F. The Office action identifies no errors whatsoever with the specific reasoning or opinion of Dr. Ligler.

At page 56 of the Office action, the Examiner recognizes that applicants have submitted arguments showing that the claims find support in both specifications. The Examiner however requests further clarification:

[I]t is unclear from these arguments what ‘standard’ of proof applicants and applicants’ expert have adopted in support of their conclusions. That is, it is unclear whether applicants and their expert are alleging that the respective 1981 and 1987 disclosures being relied upon for ‘proof’ of priority do in fact describe the ‘same invention’ and therefore constitute ‘common subject matter’ as is required under section 120 or, alternatively, whether applicants and their expert continue to base their arguments on the premise that ‘the same invention’/‘common subject matter’ is not a requirement of section 120 and are therefore continue [sic] to

improperly base their conclusions of adequate ‘dual’ support based on nothing more than alleged ‘correlated’ 1981 and 1987 subject matter.

Office action at 56. Applicants maintain that the *subject matter of independent claim 2* is sufficiently described in the 1981 specification and is sufficiently described in the 1987 specification. The Examiner has failed to provide any reason why either the 1981 specification or the 1987 specification fails to support the subject matter of independent claim 2, and dependent claims 3, 4, 7, 10, 13-15 and 17, under *any* interpretation of the requirements of § 120. Applicants’ proper application of the requirements of § 120 on a claim-by-claim basis is presented below where relevant. *See* Section H.12.a below addressing the rejection based on the intervening reference to Fujino.

### **C. Response To Appendix VI**

In Appendix VI of the Office action, the Examiner repeats a list of more than 30 “Examples”/“Issues” all of which except number 33, were included in prior Office actions. The “Examples”/“Issues” discuss miscellaneous issues arguably related to §§ 112 and 120. This is the third time in which the vast majority of these “Examples”/“Issues” have appeared in an Office action in this application. In the Prior Office action, the Examiner stated that the list of “Examples” would be maintained by the Patent Office in all of applicants’ related applications “in an attempt to ensure consistency in the way that these issues are handled between applications in the future.” Prior Office action, p. 56. Notwithstanding the Examiner’s attempt to ensure consistency, the list of Examples is an ever-changing “list” with numerous additions, deletions, and other changes appearing over time.<sup>1</sup> It appears that the only “entirely” new “Example”/“Issue” is number 33. While the Examiner has taken time to correct minor

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<sup>1</sup> For example, prior to the Office actions received in 2004 in the instant application and application serial number 08/470,571, the most recent “List of Examples” appeared in the Office action mailed on July 30, 2003, in application serial number 08/444,788. While many of the changes between the list appearing in the Office action mailed on July 30, 2003 and the instant Office action are trivial and grammatical corrections, the Examiner has deleted several “Examples” (e.g., “Examples 22, 24, and 26 have been removed) and inserted substantive additions to others.

grammatical errors and make substantive revisions to many of these “Examples”/“Issues,” the Examiner has not commented on, or even acknowledged, applicants’ prior responses to the “Examples”/“Issues.”

Applicants have previously responded to all but one of the 33 “Examples”/“Issues,”<sup>2</sup> and continue to believe that all of these “Examples”/“Issues” should be withdrawn in their entirety. Applicants reserve their right to further address any issue raised in the “Examples”/“Issues” if the Examiner makes an actual rejection or objection based on any of the issues raised in the “Examples”/“Issues.”

Regarding Example 33, the Examiner addresses applicants’ arguments from the Response filed January 9, 2003, in application number 08/470,571 regarding a specific rejection in the July 17, 2002, Office action. The Examiner withdrew this rejection in the subsequent Office action mailed April 28, 2004. Applicants maintain that the claimed invention is patentable over the references cited by the Examiner. Applicants fully set forth the distinctions between the claimed invention and art related to viewdata whenever the Examiner applies such art.

#### **D. Response to Rejections Under § 112, First Paragraph**

In Section E2 the Examiner rejects all of applicants’ pending claims under 35 U.S.C. § 112, first paragraph, for lack of written description support. Specifically, the Examiner alleges that applicants’ 1987 specification does not support the step in claim 2 of “determining content of a second medium received in said plurality of signals.” The Examiner’s rejection under § 112, first paragraph, should be withdrawn for several reasons.

First, the Examiner has failed to satisfy his burden to sustain the rejection under § 112, first paragraph. In the Prior Office action, claim 2 was rejected for failure to satisfy the written description requirement of § 112, first paragraph. In rejecting claim 2 under § 112, first paragraph, the Examiner stated that “[i]t is not clear where the disclosure as originally filed

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<sup>2</sup> See, e.g., applicants’ January 2003 Response filed in the instant application and applicants’ January 30, 2004 Response filed in application serial number 08/444,788.

disclosed the ‘content’ of the second medium that is determined in line 9. Clarification is needed.” Prior Office action, at p. 98. In response to this rejection, applicants submitted the Ligler Declaration in accordance with 37 C.F.R. § 1.132, which accompanied applicants’ January 2003 Response.

The Ligler Declaration demonstrates that the subject matter of claim 2 is sufficiently described in both the 1981 and the 1987 specifications such that a person of ordinary skill in the art would conclude that applicants invented the invention of claim 2 as of the filing date of applicants’ 1981 specification. The Ligler Declaration provides citations to applicants’ 1981 and 1987 specifications precisely pointing out the portions of those specifications that support each and every recited limitation of claim 2. The Ligler Declaration indicates that the step of “determining content of a second medium received in said plurality of signals” is supported by the disclosure of the 1981 specification at e.g., col. 19, ll. 12-23 and the disclosure of the 1987 specification at e.g., p. 435, l. 23 to p. 436, l. 1. Ligler Declaration, at p. 7. Additionally, the Ligler Declaration provides a narrative explanation detailing how claim 2 is supported by the disclosure of each specification. Regarding the “determining content” step, the Ligler Declaration states that “[i]n both the 1981 and 1987 specifications a program identifier received in advance of the exemplary Wall Street Week broadcast is used to determine content of the Wall Street Week television program.” Ligler Declaration, at pp. 8-9.

The law is clear that examiners must take into account and analyze a declaration submitted by an applicant in response to a rejection under the first paragraph of 35 U.S.C. § 112.

Upon reply by applicant, before repeating any rejection under 35 U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under 35 U.S.C. 112, para. 1, fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. When a rejection is

maintained, any affidavits relevant to the 35 U.S.C. 112, para. 1, written description requirement, must be thoroughly analyzed and discussed in the next Office action.

MPEP § 2163.04. *See also In re Alton*, 76 F.3d 1168, 1176, 37 U.S.P.Q.2d 1578, 1584 (Fed. Cir. 1996).

The Examiner has failed to follow the guidelines set forth in the MPEP. First, the Examiner does not challenge, refute, or even acknowledge the Ligler Declaration with respect to this issue. Second, it is clear that the Examiner did not even consider the Ligler Declaration because the Examiner incorrectly asserts that applicants rely on “the described ‘act of detecting’ the overlay command signal” to support the “determining content” step of claim 2. The Ligler Declaration identifies the use of the *program identifiers* described in both specifications to support the “determining content” step of claim 2. As the Examiner has failed to acknowledge, analyze or discuss the Ligler Declaration’s reasons why the subject matter of claim 2 is adequately supported in applicant’s specifications, the Examiner has not met the burden required to sustain his rejection of claim 2 under § 112, first paragraph. Accordingly, applicants respectfully request that the Examiner withdraw this rejection.

Without elaboration, the Examiner asserts that “support for the ‘content’ terminology in the context of claims 8-10 and 14-16 is, for similar reasons not apparent and/or not understood” and that “clarification regarding support for the ‘content’ terminology is needed as recited in the context of claims 20, 24, 26, 29, 30, 33, 37, 38, 70, 74, 76, 85, and 95.”<sup>3</sup> The Ligler Declaration identifies the written description support contained in both of applicants’ specifications for each of these claims. Accordingly, for at least the same reasons discussed above with respect to claim 2, the Examiner’s rejections of claims 8-10, 14-16, 20, 24, 26, 29, 30, 33, 37, 38, 70, 74, 76, 85, and 95 should be withdrawn.

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<sup>3</sup> As discussed in Section II.F, the Examiner has misconstrued the “determining content” step of claim 2. In contrast, Dr. Ligler’s analysis is entirely consistent with the proper interpretation of this term.

**E. Response to Rejections Under § 112, Second Paragraph**

In Section E3, the Examiner rejects claims 70-73, and the claims dependent therefrom, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicants regard as their invention. The Examiner asserts that claim 73 is directed to an apparatus, but that the claim includes the following “functional language . . . that is not supported by recitations of corresponding structure”:

wherein said information based on said second medium is generated based on identifying content of said second medium.

Office action, p. 60. The Examiner further states that the “structure for providing the recited generation and structure for providing the recited identification of content has not been positively recited as required of an apparatus claim.” *Id.* Contrary to the Examiner’s assertion it is not improper or otherwise objectionable under § 112, second paragraph, to include descriptions of functions performed by apparatus recited in a claim directed to such apparatus. M.P.E.P. § 2173.05(g). Notwithstanding this fact, applicants note that the recitation that the Examiner objects to is contained in the claim limitation directed to a microcomputer. Accordingly, applicants include in claim 70 (and the claims depending from claim 70) a structure for performing the recited generation and identification in claim 70.

**F. Response To Prior Art Rejections**

Before turning to the specific claim rejections under 35 U.S.C. §§ 102 and 103, applicants wish to address a claim interpretation error that is repeated by the Examiner throughout the Office action. In particular, the Examiner has erroneously construed the term “content.” The phrases “determining content” and “identifying content” of media are thus misconstrued by the Examiner in a manner that invites rejections based on references that simply disclose detecting portions of transmission signals. For example, many of the rejections are based on television references, with the Examiner taking the position that television synchronization signals constitute “content” of a medium that is determined or identified. For the reasons set forth below, these rejections are based on an *unreasonable* interpretation of



“determining content” and “identifying content.” The rejections based on this unreasonable interpretation should be withdrawn.

MPEP § 2111 clearly sets forth the manner by which the Examiner should interpret claims during examination. Specifically, the pending claims must be “given their broadest *reasonable* interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000) (emphasis added). This means that the words of the claim must be given their plain meaning unless applicants have provided a clear definition in the specification. *Id.*; *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 U.S.P.Q.2d 1857 (Fed. Cir. 2004). The MPEP further points out that “plain meaning” refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. *Sunracer Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 U.S.P.Q.2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 U.S.P.Q.2d 1132, 1136 (Fed. Cir. 2003). The ordinary and customary meaning of a term may be evidenced from a variety of sources, including dictionaries. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 U.S.P.Q. 2d 1812, 1818 (Fed. Cir. 2002).

Applying this procedure, an appropriate place to start is with the definition of “content.” Webster’s Ninth New Collegiate Dictionary (1985) defines “content” as follows:

**1content** \kən-'tent\ *adj* [ME, fr. MF, fr. L *contentus*, fr. pp. of *continēre* to hold in, contain — more at CONTAIN] (15c): CONTENTED, SATISFIED

**2content** *vt* (15c) **1:** to appease the desires of **2:** to limit (oneself) in requirements, desires, or actions

**3content** *n* (1579): CONTENTMENT <ate to his heart's ~>

**4con•tent** \'kän-'tent\ *n* [ME, fr. MF, fr. L *contentus*, pp. of *continēre* to contain] (15c) **1 a:** something contained — usu. used in pl. <the jar's ~s> <the drawer's ~s> **b:** the topics or matter treated in a written work <the table of ~s> **2 a:** SUBSTANCE, GIST **b:** MEANING, SIGNIFICANCE **c:** the events, physical detail, and information in a work of art — compare FORM 10c **3 a:** the matter dealt with in a field of study **b:** a part, element, or complex of parts **4:** the amount of specified material contained : PROPORTION

The MPEP provides guidance on what to do when there are several definitions for a term. Specifically, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicants' use of the term. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 U.S.P.Q.2d 1117, 1122 (Fed. Cir. 1998).

Applicants' invention is in the field of telecommunications. The specification notes that for mass media, program content is the same for every viewer. Spec. p. 1, ll. 26-32. It is this information content of programming that is viewed at the receiver station. Spec. p. 390, ll. 14-23.

Given this field of the invention, the logical choice for the definition of "content" in this context is "substance," "gist," "meaning" or "significance." Accordingly, "content" is properly construed to mean "substance" in contrast to "form" or "structure." This definition is in accord with the use of the term "content" with the terms "medium" and "media" which connote a channel of communications. Accordingly, the "content" of a medium should be interpreted to mean the substance of a channel of communications. The specification provides examples of determining or identifying the substance, gist, meaning or significance of a channel of communications. For instance, program identifiers are used to determine which television program is being transmitted on a particular channel. Spec. p. 435, l. 23 - p. 436, l. 1; p. 252, ll. 31-35. Similarly, other content, such as the closing prices of particular stocks, is identified in other communications. Spec. p. 449, ll. 13-35.

The prior art rejections in the Office action strongly suggest that the Examiner has construed the term "determining content" to simply mean "detecting a portion of a transmission signal." As properly construed, the synchronization signals of a television video signal are not "content" of a medium. Rather the synchronization signals are part of the structure of the underlying electromagnetic signal. In other words, the substance of what is communicated over the television video signal is independent from the synchronizing pulses. Isolating the line synchronizing pulses does not determine or identify the substance, gist, meaning or significance of the medium (e.g., they do not signify what television program is being provided via the

television broadcast). For at least this reason, all rejections premised on the notion that synchronization signals constitute “content” should be withdrawn.

### **G. Response To § 102 Prior Art Rejections**

Under 35 U.S.C. § 102, the Office bears the burden of presenting at least a *prima facie* case of anticipation. *Chester v. Miller*, 906 F.2d 1574, 15 U.S.P.Q.2d 1333 (Fed. Cir. 1990). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *See e.g., Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986) (“[A]bsence from the reference of any claimed element negates anticipation.”). “In addition, the prior art reference must be enabling.” *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1479, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. *In re Donohue*, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” *Id.*

#### **1. Rejection Based On Turner**

Claims 2-6 and 11-16 stand rejected as being anticipated by British patent 1 486 424 naming Simon Royce Turner as inventor (“Turner”). Turner relates to a television transmission system for transmitting additional data within the normal television video signal.

##### **a. Independent Claim 2**

In section E-4 of the Office action, claim 2 is rejected as being anticipated by Turner. In claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

In particular, claim 2 sets forth a step of determining content of the second medium. Turner does not teach determining the content of any medium. As described in both the 1981 specification and the 1987 specification, a program identifier is received in advance of the “Wall Street Week” broadcast and is used to identify the information content of the broadcast. The content (the “Wall Street Week” program) of the television broadcast (second medium) is identified.

In contrast, Turner displays character data. Turner p. 2, ll. 29-44. Turner may also display a television picture. Turner p. 2, ll. 38-49. Turner does not teach determining the content of either the character data or the television picture. Turner uses the line synchronizing pulses of the television signal to clock the data bits representing characters into the line blanking interval in the television signal at a rate of only one data bit per television line. Turner, p. 1, ll. 74-91. In the Office action, a synchronising pulse separator 37 is cited as “determining a sync signal ‘content’ of a second video media.” However as discussed in Section F above, the line synchronizing pulse is not the content of either the character data or the television video, nor is it used to determine the content of the character data of the television video.

Claim 2 sets forth coordinating a presentation using the information from the first medium with a presentation of the second medium based on the step of determining. As Turner fails to teach a step of determining as set forth by claim 2, Turner does teach coordinating a presentation based on the step of determining. The applied art simply does not show coordinating a presentation based on determining the content of a television program. There is no teaching to coordinate based on a step of identifying the substance of the television program.

Claim 2 sets forth outputting the multimedia presentation based on the step of coordinating such that the presentation using the information from the first medium has a predetermined relationship to the content of the second medium. The Office action is silent regarding the relationship between the character data and the content of the television picture of Turner. In addition, as Turner does not show a step of coordinating as claimed, Turner does not teach outputting based on the step of coordinating.

**b. Claims 3-6 And 11-16**

Claims 3-6 and 11-16 depend from claim 2. In Section E-5 of the Office action, these claims are rejected as being anticipated by Turner. The Office action provides no reasons whatsoever for the rejections of claims 3-5, 11 and 12. Accordingly, a *prima facie* case of anticipation has not been established against these claims. As each of these claims depends from claim 2 and, thus, includes the limitations of claim 2, these claims are not anticipated by Turner for at least the reasons set forth above with regard to claim 2.

Additionally, claim 13 sets forth that the step of determining comprises processing an identifier. Claim 14 depends from 13 and further sets forth that the identifier identifies the content of the second medium. Claim 15 and 16 depend from claim 14 and set forth that the content of the second medium includes audio and video respectively. In the Office action, it is asserted, "Sync signals are inherently 'identifiers' of a specific timing content of the TV signal." The content of a television program is not identified by sync signals for the reasons set forth in Section F above.

**2. Rejection Based On Yoshino**

Claim 2 stands rejected under 35 U.S.C. § 102(b) as being anticipated by British patent 1 405 141 naming Hirokazu Yoshino et al. as inventor ("Yoshino"). Yoshino is directed to an electronic calculator that outputs a multiple row display in superposition with television video. Yoshino, like Turner, is merely directed to the display of character data with television video. Yoshino does not anticipate claim 2 for reasons similar to those set forth above with respect to Turner.

As discussed above, claim 2 sets forth a step of determining content of a second medium. Yoshino fails to teach this step. The Office action asserts that Yoshino comprised "Circuitry (@ 14) for determining a timing 'content' of the received TV signal by detecting sync signals contained therein." Yoshino includes a synchronizing circuit 14 for supplying the horizontal and vertical synchronizing signals for the display control circuit. As discussed in Section F above,

detecting sync signals is not determining content of a TV program. For at least this reason, Yoshino does not teach a step of determining content of second medium.

Yoshino does not teach the steps of coordinating and outputting for reasons similar to those set forth above with respect to Turner. As Yoshino does not teach a step of determining as set forth by claim 2, Yoshino does not teach coordinating based on the step of determining. As Yoshino does not teach a step of coordinating as set forth by claim 2, Yoshino does not teach a step of outputting based on the step of coordinating. Furthermore, claim 2 sets forth that the presentation using the information from the first medium has a predetermined relationship to the content of the second medium. Yoshino teaches no predetermined relationship between the image data of the computed information and the television program.

### **3. Rejections Based On Zaboklicki**

Claims 2, 3-18, 20, 21-23, 26, 27, 37-42, 67-69, and 82-84 are rejected under 35 U.S.C. § 102(b) as being anticipated by German patent application 29 04 981 naming Edward Zaboklicki as inventor ("Zaboklicki").

The teaching of Zaboklicki is obscure. The Examiner continues to summarize the alleged showing of Zaboklicki at pp. 65-66 of the Office action. Applicants do not accede to the Examiner's assertion of the teachings of Zaboklicki. Zaboklicki does not disclose each and every limitation of the claims. Applicants' maintain that Zaboklicki is not enabling. The Examiner has provided a summary of his interpretations of various references deemed related to interactive television in Section D-3 of the response. This summary seems to be considered necessary by the Examiner to clarify the teaching that the Examiner desires to find in Zaboklicki: it is not, however, the actual teaching of Zaboklicki nor is the summary prior art. Zaboklicki does not sufficiently describe the claimed invention so as to have placed the public in possession of it as is required to be applicable as prior art. M.P.E.P. § 2121.01.

**a. Claim 2**

Section E-7 of the Office action rejects claim 2 as being anticipated by Zaboklicki. Zaboklicki, like Turner and Yoshino, fails to teach a step of determining content of a second medium. Further demonstrating the obscurity of the teaching of Zaboklicki, the Office action offers two interpretations of the applied reference against claim 2. Teletext decoder 56 is relied upon to show determining content in both interpretations. In the first interpretation, it is asserted that the teletext decoder is “for determining ‘content’ of other media [i.e., for detecting the page number content of the teletext media; for detecting the control signal content of the teletext media, for detecting program segment/fragment identifier content of the primary and secondary video/audio components, etc. . . .]” In the second interpretation, it is asserted that the teletext decoder is “for determining ‘content’ of other media [i.e., for detecting a ‘telesoftware’ content of the program segments/fragments; for detecting program segments/fragment identifier content of the primary and secondary video/audio components, etc.]” The fundamental flaw with both interpretations is that the Zaboklicki reference itself provides no support for these assertions. The Examiner does not point to any teaching of Zaboklicki that ascribes these functions to the teletext decoder 56.

With regard to determining content of teletext media, Zaboklicki fails to anticipate claim 2. First, the Office action points to no teaching by Zaboklicki that the teletext decoder 56 detects any page numbers, control signal content, or program segment/fragment identifier content. Zaboklicki includes no teaching of this function of decoder 56. Furthermore, in this interpretation, the Office action relies on memory 7 to show storing “telesoftware.” Zaboklicki fails to teach that any telesoftware is stored by memory 7. Furthermore, the Office action is unclear regarding the presentations that are alleged to be coordinated and output when the first interpretation of Zaboklicki is used. Zaboklicki fails to teach that teletext is coordinated with audio or television programming based on determining the content of the teletext.

With regard to determining content of “telesoftware,” there is no teaching in Zaboklicki that any “telesoftware” is a communications medium. When using this alternate interpretation,

the Office action relies on teletext data, audio components and television components to show coordinated presentations. This is inconsistent with the reliance in the Office action of the “telesoftware” to show a second medium. Zaboklicki fails to teach determining content of a second medium which is coordinated with stored information from a first medium, where the presentation using the information has a predetermined relationship to the content of the second medium as set forth in claim 2.

**b. Claims 3-18**

In Section E-8, claims 3-18 are rejected as being anticipated by Zaboklicki. Claims 3-18 depend from claim 2 and are thus allowable over Zaboklicki for at least the reasons set above with respect to claim 2. The Office action briefly addresses a few selected limitations from certain ones of these dependant claims. Not all the claims are specifically addressed. Furthermore, except for the rejection of claims 3 and 4, it is unclear whether these rejections rely on the first interpretation of Zaboklicki or the second alternative interpretation of Zaboklicki set forth with respect to claim 2. For example, claim 7 sets forth that the content of the second medium explains a significance of the presentation using the information from the first medium. The Office action does not address this claim. Claim 8 sets forth that the content of the second medium explains the significance in audio. The Examiner relies on the secondary audio signal content to show “explanations.” This appears to be inconsistent with the rejection of claim 2 as neither interpretation of Zaboklicki seems to rely on the secondary audio as the second medium. It is unclear what “explanations” the Office action relies upon, as it is unclear what is relied upon to show a first medium from which first information is stored. The Office action merely points to a number of vague features in Zaboklicki, such as audio “explanations,” and attempts to assemble these features in a manner not taught by Zaboklicki. Accordingly these rejections based on Zaboklicki are improper.



**c. Claim 20**

Section E-9 of the Office action rejects claim 20 as being anticipated by Zaboklicki. Claim 20 sets forth that a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium, whereby the content of the first and second media are identified. The Office action does not assert that Zaboklicki teaches each limitation of claim 20. Instead, the Office action asserts that the identifiers and step of identification of claim 20 are inherent in Zaboklicki. The teaching of Zaboklicki is vague -- there are no details regarding how any of the features touched upon are actually implemented. There is no evidence that Zaboklicki describes an operable system and there is no basis to assert that any particular characteristic is necessary to the Zaboklicki system.

Zaboklicki fails to teach identifying content of a first medium based on an identifier. Zaboklicki fails to teach controlling a receiver station, based on the step of identifying, to enable a coordinated presentation of the first medium and information generated based on identifying content of a second medium. The Office fails to identify first and second media in Zaboklicki as set forth in claim 20. Applicants submit, therefore, that the Office action fails to establish that Zaboklicki teaches each limitation of claim 20.

**d. Claims 21-23, 26, 27, 37-42, 67-69 And 82-84**

In Section E-10 of the Office action, claims 21-23 are rejected as being anticipated by Zaboklicki for the same reasons that were set forth for claim 20. In Section E-11 of the Office action, claims 26, 27, 37-42, 67-69 and 82-84 are rejected as being anticipated by Zaboklicki for the same reasons that were set forth for claim 20. No basis for these rejections is set forth in the Office action. As the Office action includes no attempt to show how Zaboklicki teaches the limitations of these claims, the rejection of these claims is improper. As discussed above, the teaching of Zaboklicki is obscure. The Office action relies on alternate "interpretations" of the reference and relies on matter not set forth in the reference but deemed to be inherent. Accordingly, there is no reasonable way for applicants to discern why the Examiner considers

Zaboklicki to teach the elements of claims 21-23, 26, 27, 37-42, 67-69 and 82-84. Accordingly, the rejections of these claims over Zaboklicki are entirely improper.

#### **4. Rejections Based On Morchand**

In section E-12 of the Office action, claim 33 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,008,000 to Charles A. Morchand ("Morchand").

In claim 33, a multimedia presentation of information included in a first signal received from a remote transmitter station and information included in a second signal is output, whereby a user response is compared to information corresponding to content of the first signal in order to tune the receiver station to receive the second signal.

Morchand contemplates providing an information transfer system that comprises a plurality of sources of information. Selection means at the receiver are operable by the viewer in response to the presented information so that the viewer may select one of the sources. Control means controls the selection means only when the received control function is related to the source selected by the subject. Morchand col. 1, l. 69 - col. 2, l. 10. The control means of Morchand includes photocells 40 in a control unit 26 disposed over predetermined areas of the display tube 42. Morchand col. 2, ll. 59-62. Each photocell is connected to a switch 44 in a selection unit 28 operable by the viewer. Morchand col. 2, ll. 64-68. The output of the switch controls a solenoid 50 in a switching unit 30 that moves a switch 32 of a channel selector 18B. Morchand col. 2, l. 69 - col. 3, l. 1. Accordingly, a viewer response in Morchand is merely holding a selected switch closed at a designated time. During the designated time, flashes of light are incorporated in parts of the picture under the photocells. The channel selector is moved a number of times equal to the number of flashes at the photocell associated with the selected switch.

Claim 33 sets forth comparing the user response to information corresponding to content of the first signal. Morchand fails to teach such a step. To the contrary, Morchand teaches that a particular portion of the video is converted to electrical impulses by a photocell 40 associated

with a switch selected by a user. These pulses in an amplified form are used to change the channel of the device. The user merely selects the desired switch that transfers the associated pulses to the channel selector. No information is compared in the Morchand device. The user never has any reason to input or even to know the number of flashes that are broadcast at the appropriate photocell site.

## **H. Response To § 103 Prior Art Rejections**

To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all of the claim recitations. M.P.E.P. § 706.02(j) (8<sup>th</sup> ed. 2001). Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In order to support a § 103 rejection based on the modification of a single reference, the Examiner must provide specific evidence to show *why* one of ordinary skill would be motivated to modify the reference in such a way to incorporate all of the claimed elements. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000) ("Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.") (emphasis added). Broad conclusory statements concerning motivation to modify, standing alone, are not sufficient to support an obviousness rejection. *See In re Freed*, 425 F.2d 785, 787, 165 U.S.P.Q. 570, 571-72 (C.C.P.A. 1970) (an obviousness rejection must be based on facts, "cold hard facts"); *In re Kotzab*, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1317 ("Broad, conclusory statements standing alone are not 'evidence.'"). Accordingly, a statement that a modification would be an "obvious design

choice,” without factual support, is insufficient as a matter of law. *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000). Finally, as the absence of a suggestion to modify a reference is dispositive in an obviousness determination, a rejection which fails to provide specific evidence as to *why* one of ordinary skill would be motivated to modify the relevant reference is insupportable, as a matter of law. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 U.S.P.Q.2d 1378 (Fed. Cir. 1997).

In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002) (“‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the modification of a single reference, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 U.S.P.Q.2d at 1617-18.

As set forth in greater detail below, the Examiner has failed to follow these requirements when making the § 103 rejections of the claims of the instant application. For this reason alone, the § 103 rejections should be withdrawn.

**1. Rejection Based On Barnaby, Okada, And Betts**

Claims 24, 25, 74, 75, 103 and 104 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,982,064 to Barnaby (“Barnaby”) in view of Japanese patent publication 56-8975 naming Yashuhito Okada et al. as inventors (“Okada”). Claims 74 and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of Barnaby in view of Okada and further in view of British patent specification 1 556 366 naming William Robert Betts as inventor (“Betts”).

In claim 24, a multimedia presentation of a television program and a second medium is output, whereby information stored at a receiver station is compared to content of a television program to determine whether to present the second medium based on information received from a source different from that of the television program. Claims 25 and 103 depend from claim 24. Claim 74 is an apparatus claim that corresponds substantially to claim 24. Claims 75 and 104 depend from claim 74.

Barnaby sets forth a system in which data is transmitted during the vertical blanking interval of a television signal. In Barnaby, each data line is transmitted during a single line scan period. A first line identifies a page number. In subsequent blanking intervals, data lines are transmitted with a start signal and line address. Barnaby col. 2, ll. 24-34. The Office action has provided only a brief English abstract of the Okada reference. It appears that the Office action relies only on this abstract and the figures of the Okada reference. The abstract asserts that the purpose of Okada is to “obtain a television multiplex character broadcast receiver which can obtain the hard copy of a character broadcast picture without reference to whether the character broadcast picture is projected on a screen.” Betts is directed to a teletext display system for displaying pages of data.

The Examiner's reliance on the abstract of Okada, rather than a translation of the underlying document, is improper. "If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." M.P.E.P. § 706.02 II. The rejections based on Okada should be withdrawn or the Examiner should provide a translation of Okada.

Claim 24 sets forth a step of comparing first information stored at a receiver station to second information corresponding to content of a television program. Claim 74 likewise sets forth a microcomputer for storing first information and comparing the first information to second information corresponding to content of a television program. In the Office action, it is acknowledged that Barnaby does not suggest these limitations. "Barnaby does not state that the page number input (@ 22) 'corresponds to content' of the received TV programming." Office action at 73.

The Examiner takes Official Notice that it was notoriously well known to those of ordinary skill in the art at the time of applicants' invention for a user to enter page numbers that pertain to "program-related" teletext pages. The Office action includes footnote 33 citing to "Oracle on Independent Television" by Green et al. and PCT publication WO 81/02961. Applicants are uncertain as to whether the casual reference to these publications was intended to form a four or five reference obviousness combination. In any event, these two citations demonstrate that systems implementing "program-related" teletext pages were not well known. Both of these references merely contain aspirational statements that text may supplement television programs. No details are provided in either reference. There is no suggestion that the material is output with the television programming in a coordinated presentation. Accordingly, applicants traverse the Official Notice taken by the Examiner. None of the cited references suggest outputting related content at a second output device. There is no suggestion in the applied art to compare stored first information to second information corresponding to content of a television program.

Claim 24 further sets forth outputting the television program at a first output device and the second medium at a second output device. Claim 74 likewise sets forth a first output device for outputting the television program and a second output device for outputting the second medium. The Office action acknowledges that Barnaby does not suggest separate output devices for first and second media. Okada is relied upon to show a printing device. The Office action fails to identify any suggestion or motivation to combine the teachings of Barnaby and Okada. The limited English abstract of Okada relied upon by the Examiner fails to support the broad conclusion that Okada demonstrates that it was known and desirable to those of ordinary skill to have added appropriate selection and switching circuitry to conventional teletext receiving stations to enable users to selectively output received teletext images to a separate output printing device. The Examiner merely asserts that the Okada system is desirable. There is no suggestion to modify the Barnaby system using teachings from Okada.

There is simply no showing or suggestion in the applied art of a user selecting program related teletext pages for printing as suggested by the Office action. The Examiner resorts to relying on an untranslated Japanese application and Official Notice to show these elements of claims 24 and 74. The only suggestion to combine the above features to result in a user selection of program related teletext pages for printing is found in applicants' specifications.

Claims 25 and 103 depend from claim 24 and, thus, are patentable over Barnaby in view of Okada for the above reasons. Similarly, claims 75 and 104, depending from claim 74 are patentable over Barnaby in view of Okada. Furthermore, claims 103 and 104 set forth that the television program and the third information are included in first and second channels, respectively, of a multichannel cable transmission. In section E-15 of the Office action, it is merely asserted that it would have been obvious to convey broadcast TV signals of Barnaby and Okada using a multichannel cable system. Even if this unsupported statement was true, it is insufficient to support a rejection of claims 103 and 104. The mere use of a cable transmission system does not suggest that television programming is included in a first channel while third

information providing the basis for a second medium to be coordinated with the television program is included in a second channel.

## **2. Rejection Based On Komori And Long**

Claims 26, 27 and 82 stand rejected as being unpatentable over Japanese published application 52-22423 naming Atsushi Komori as inventor ("Komori") in view of U.S. Patent No. 4,081,990 to Long ("Long").

In claim 26, a multimedia presentation of information included in one medium and information based on another medium is output, where content of each of the two media is identified and where one of the media is received from a remote transmitter station and the other medium is received from a different source. Claims 27 and 82 depend from claim 26.

The Examiner has provided an untranslated copy of Komori with a brief English abstract. The summary states that the purpose of Komori is to combine a binary video signal and another video signal by matching their phases. Long is directed to synchronizing unrelated video signals by converting the signals to digital form, storing the digital signals, and then reading out the signals by clocking the signal to a local sync generator.

The Examiner's reliance on the abstract of Komori, rather than a translation of the underlying document, is improper. "If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." M.P.E.P.

§ 706.02 II. The rejections based on Komori should be withdrawn or the Examiner should provide a translation of Komori.

Claim 26 sets forth identifying content of a first and content of a second of a plurality of media. Neither Komori nor Long address identifying content of any television program. The Office action relies on the sync separation circuits of Komori and the clock units of Long to show a video processing device which "[i]dentified . . . a sync signal 'content' of the . . . video signal media." As discussed in Section F above, sync signals are not content of media.



Accordingly, Komori and Long both fail to suggest identifying content of a first medium and content of a second medium as set forth by claim 26.

Claims 27 and 82 depend from claim 26 and thus include each limitation of claim 26. Claims 27 and 82 are patentable over Komori and Long for at least the reasons set forth above with respect to claim 26. Claim 82 sets forth that the first medium comprises a television program including video and audio. The Office action asserts, "One of ordinary skill in the art would have understood the fact that the respective video signals included an audio component processed therewith in a like manner." There is no such teaching in the applied art. The Komori abstract refers only to video signals. Long relates to "processing video type signals" Long col. 1, l. 6. The Examiner relies specifically on the "sync signal 'content'" of video signals in Long and Komori. There is no suggestion to process an audio component in a like manner.

### **3. Rejection Based On Kashigi, Komori And Long**

In section E-18 of the Office action, claims 26-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of U.S. Patent No. 4,218,710 to Kazuo Kashigi and Toshitake Koyama ("Kashigi") in view of Komori and Long.

Kashigi is directed to a digital video effects system. Kashigi discusses combining different television signals by converting analog signals to digital form and then producing a combined signal from the digital data using a reference timing signal.

As discussed above with respect to Komori and Long, claim 26 includes a step of identifying content of a first and content of a second of a plurality of media. Kashigi fails to suggest this step. In the Office action, it is asserted that the Kashigi system identifies a sync signal "content" of "video signal media." For the reasons set forth in Section F above, the mere separation of video sync signals fails to identify the content of the communication medium. The secondary references to Komori and Long are deficient for the same reasons as discussed above with respect to the rejection based solely on these two references.

Claims 27 and 28 depend from claim 26 and thus include each limitation of claim 26. Claims 27 and 28 are patentable over Komori and Long for at least the reasons set forth above with respect to claim 26.

**4. Rejection Based On Marsden, Germany, Diederich, Schloss And Chiddix**

Claims 2-6, 11-16, 20-23, 29, 30, 76-81 and 85-94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of British patent specification 871,238 naming Bernard Marsden as inventor ("Marsden"), British patent specification 959,274 naming Leslie Walter Germany as inventor ("Germany"), and German unexamined application 23 59 969 naming Werner Diederich as inventor ("Diederich") in view of the publication "Controlling Cable TV Head Ends and Generating Messages by Means of a Micro Computer" by Robert E. Schloss et al. ("Schloss"). Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of any one of Marsden, Germany and Diederich in view of Schloss and further in view of the article "Automated Videotape Delay Of Satellite Transmissions" by Jim Chiddix ("Chiddix").

The Office action relies on automated insertion of advertising at local television stations. The Office action describes the Examiner's understanding of such automated systems. It is asserted that such a "conventional automated" system is illustrated by any one of Marsden, Germany or Diederich. Applicants disagree with the Examiner's summary of the features of "conventional automated" systems for the reasons set forth below and request that the Examiner demonstrate where in the applied prior art the features relied upon in the rejections can be found. Marsden is directed to a means for producing a cue or warning signal for insertion in a television signal. Germany is directed to a cueing system for television. Diederich is directed to an electronic image and tone return apparatus.

**a. Claim 29**

In claim 29, a multimedia presentation of a first medium and a video image is output through processing a control signal at a receiver station which causes execution of processor instructions to create a series of discrete video images, whereby a video image of the series of discrete images is caused to be output after the identification of the first medium.

Particularly, claim 29 sets forth a step of identifying content of a first medium. In the Office action it is asserted that the conventional “automated system” necessarily comprised “[c]ircuitry for receiving and decoding the ‘instruction signal’ that are [sic] embedded within the received network TV programming to ‘*identify content*’ of the network TV programming; i.e., to identify portions/segments of the network TV programming that are to be replaced with local/regional advertising.” The Examiner has failed to give meaning to the term “content” in claim 29. It is not clear what signals in the cited art the Examiner relies upon to show “instruction signals.” Regardless, the cited references do not suggest cue signals that identify content of a first medium. As discussed in Section F above, the “content” of a medium should be interpreted to mean the substance of a channel of communications. The Examiner asserts that the “instruction signals” “identify portions/segments of the network TV programming that are to be replaced with local/regional advertising.” The Examiner does not suggest that the content (i.e., the substance) of these portions/segments is identified. To the contrary, as shown in Marsden, the cue signal may indicate a break after which no content is transmitted. “[I]n commercial television programmes . . . it is necessary for the various stations to be advised when a break is about to occur in the programme, during which the various advertisements are radiated from the various stations, so that no undesirable pauses occur between the programme and the advertisements during which *a viewer is left with a blank screen* on his television receiver.” See Marsden p. 1, ll. 30-46 (emphasis added). There is no suggestion in the applied art that any cue signal identifies *content* of a television program.

Claim 29 further sets forth processing a control signal that causes execution of processor instructions to create a series of discrete video images. The Office action acknowledges that the

cue signal systems of Marsden, Germany and Diederich do not create a series of discrete video images by processing a control signal. Schloss is relied upon to show this step. Schloss is directed to the use of a microcomputer to control certain functions at the head end of a cable system. The functions include channel switching and character generation. The Office action asserts that the “modified system would have utilized the control ‘computer’ to generate all, or at least some, of the local/regional advertisements that replace the identified portion of the network programming.” There is no such suggestion in the applied art. Schloss does not suggest a control computer that generates local advertisements. Rather, the microcomputer of Schloss merely controls switches which may route advertisements to the proper output channel at a designated time. Schloss does not suggest the creation of local advertisements as suggested in the Office action. Schloss fails to show or suggest processing any control signal that causes execution of processor instructions to create a series of discrete video images. Furthermore, the Examiner relies on the Marsden, Germany and Diederich to show events triggered by cue signal. Schloss uses an event handling program to control switches based on an event file. There is no suggestion that these teachings are interchangeable or combinable. Moreover, neither system identifies content of any medium.

**b. Claims 30 And 91-94**

Claims 30 and 91-94 depend from claim 29. Claim 30 is rejected in Section E-19 as being unpatentable over any one of Marsden, Germany and Diederich in view of Schloss. Claims 91-94 are rejected in Section E-21 of the Office action as being unpatentable over any one of Marsden, Germany and Diederich in view of Schloss for the same reasons that were set forth for claims 29 and 30. These dependant claims are patentable over Marsden, Germany and Diederich in view of Schloss for at least the reasons set forth above with respect to claim 29. The rejections of claims 30 and 91-94 are improper as the Office action does not address the additional limitations of claims 30 and 91-94. Claim 30 sets forth that the step of identifying comprises processing an identifier. The applied art fails to suggest processing an identifier.

Claim 92 sets forth that the execution of processor instructions to create a series of discrete video images includes processing data in a second medium. The applied art suggests no such execution of processor instructions including processing data in a second medium. Claim 93 depends from claim 92 and sets forth that the second medium is received in a digital data channel. Claim 94 depends from claim 92 and sets forth a multichannel cable transmission that includes the first medium and a digital data channel including the second medium. The Office action identifies no medium received in a digital data channel and identifies no multichannel cable transmission that includes a digital data channel.

**c. Claims 85-90**

Section E-21 of the Office action rejects claims 85-90 over any one of Marsden, Germany and Diederich in view of Schloss for the same reasons that were set forth for claims 29 and 30. Claim 85 is an apparatus claim that is generally analogous to method claim 29. Claims 86-90 correspond generally to claims 30 and 91-93 respectively. These claims are patentable over Marsden, Germany and Diederich in view of Schloss for at least the reasons set forth above with respect to claim 29.

Claim 85 sets forth a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of the series of discrete video images to be output. The applied art suggests no microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal for the reasons set forth above with respect to claim 29. The applied art suggests no microcomputer for identifying content of a first medium for the reasons set forth above with respect claim 29. Claims 86-90 are patentable over Marsden, Germany and Diederich in view of Schloss for at least the reasons set forth above with respect to claims 30 and 91-93.

**d. Claims 2-6, 11-16, 20-23, And 76-81**

Claims 2-6, 11-16, 20-23 and 76-81 are rejected in Section E-21 of the Office action as being unpatentable over any one of Marsden, Germany and Diederich in view of Schloss for the same reasons that were set forth for claims 29 and 30. Claims 2, 20 and 76 are independent claims. Claims 3-6 and 11-16 depend from claim 2. Claims 21-23 depend from claim 20. Claims 77-81 depend from claim 76. The Office action presents no explanation of the rejection based on Marsden, Germany, Diederich and Schloss against these claims. Accordingly, the Office action fails to establish a *prima facie* case of obviousness against these claims. As the Office action fails to provide any reasoning demonstrating how Marsden, Germany, Diederich and Schloss render these claims obvious, it is impossible to point out the errors in the Examiner's reasoning. This rejection should be properly set forth or withdrawn.

Applicants note that at least the following elements of these claims are not suggested by the applied references.

With regard to claim 2, the applied references fail to suggest determining content of a second medium. The applied references also fail to suggest storing information from a first medium. The applied references further fail to suggest a presentation using stored information from a first medium that has a predetermined relationship to the content of the second medium.

With regard to claim 20, the applied references fail to suggest receiving a first signal including an identifier or identifying content of a first medium based on the identifier. The applied references also fail to suggest controlling the receiver station to enable a coordinated presentation of the first medium and information based on the second medium, wherein, the information based on the second medium is generated based on identifying content of the second medium.

With regard to claim 76, the applied references fail to suggest a microcomputer for identifying content of a first medium and identifying content of a second medium.

**e. Claims 17 And 18**

Claims 17 and 18 are rejected in Section E-22 of the Office action as being unpatentable over the three reference combination of any one of Marsden, Germany and Diederich in view of Schloss and further in view of Chiddix. Claim 17 depends from claim 2 and sets forth storing the second medium at the receiver station. Claim 18 depends from claim 17 and sets forth that the second medium comprises television and the first medium is received in a digital data channel of a multichannel cable transmission including the second medium.

The Office action apparently acknowledges that Marsden, Germany, Diederich and Schloss do not suggest the additional limitations set forth in claims 17 and 18. The Office action asserts that Chiddix is cited to show recording TV programming for delayed rebroadcast. However, there is no showing of how the cited art teaches or suggests the elements of claim 2 as discussed above. Accordingly, it is unclear how the use of tape delayed broadcasts show the elements of claims 17 and 18. For example, as the Office action fails to identify a first medium and second medium as recited in claim 2, applicants cannot reasonably ascertain how the Examiner applies Chiddix in combination with the four other applied references to show a step of storing a second medium as set forth by claim 17. Similarly, applicants cannot reasonably ascertain how the Examiner applies Chiddix to show a digital data channel of a multichannel cable transmission including the second medium as set forth by claim 18.

**5. Rejection Based On Morchand And Zaboklicki**

Claims 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morchand in view of Zaboklicki. Claims 34-36 depend from claim 33. Morchand fails to suggest each element of claim 33 for the reasons set forth in Section G.4 above. Zaboklicki fails to correct the deficiencies of Morchand as applied against claim 33. Claims 34-36 are patentable over Morchand and Zaboklicki for at least this reason.

The Office action acknowledges that the limitations set forth in claims 34-36 are not suggested by Morchand. The Office action merely asserts that these features are present in the Zaboklicki reference and thus it would have been obvious to modify the Morchand system to

include these features. There is no suggestion or motivation found in the prior art to modify Morchand based on the obscure teachings of Zaboklicki.

Claim 34 sets forth transmitting information from the receiver station based on the step of receiving the user response. Claim 36 depends from claim 34 and sets forth that the transmitted information is transmitted by telephone. The Office action notes that figure 4 of Zaboklicki shows conveying user responses to a remote location via the telephone line. However, there is no suggestion that such transmission would benefit the Morchand system in any manner. In the Morchand system, alternative programming is transmitted on alternate channels. The user input is used to tune to the appropriate channel. There is no suggestion of how the user input *if* transmitted to a remote location would be used by the Morchand system. There is no benefit or reason to modify Morchand to transmit the user response from the receiver station. Accordingly, there is no motivation to combine any teaching of Zaboklicki with the teaching of Morchand as suggested in the Office action.

Claim 35 sets forth that the information in the second signal is output to a printer. The Office action asserts that “Zaboklicki evidences the fact that it was known to have been desirable to provided [sic] the receiver in such systems a printing capability.” Applicants maintain that at best, Zaboklicki asserts the desirability of a host of features, but fails to provide the details to enable a system that actually provides the features relied upon in the Office action. Furthermore, there is no suggestion to combine any printing capability that may be shown in Zaboklicki with the teaching of Morchand. Morchand is directed to switching from one television channel to another television channel based on switches activated by the viewer. A printing capability would have no function in the Morchand system, which merely outputs television programs.

## **6. Rejection Based On Thonnart And Zaboklicki**

Claims 76-81 and 85-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,413,281 to Paul Thonnart (“Thonnart”) and Zaboklicki.



Thonnart is directed to the creation of a series of text, images, and voice commentaries through a composition device at a studio. The text pages, image scans and voice commentaries are transmitted for successive reproduction at a point of reception. Thonnart col. 2, ll. 25-46.

**a. Claim 76**

Section E-25 of the Office action sets forth a rejection of claim 76 as being unpatentable over Thonnart and Zaboklicki. Claim 76 sets forth a multimedia presentation apparatus. The apparatus as claimed includes two receivers for receiving a first and a second medium, respectively. The claimed apparatus also includes a microcomputer for identifying content of the first medium and identifying content of the second medium and controlling, based on the identified content, a multimedia presentation comprising information included in the first medium and information based on the second medium. The claimed apparatus further includes an output device for outputting the multimedia presentation. Neither Thonnart nor Zaboklicki show or suggest a microcomputer as set forth by claim 76.

The Office action acknowledges that Thonnart does not show or suggest such a microcomputer. However, neither Zaboklicki nor Thonnart show a microcomputer for identifying content of a first medium and identifying content of a second medium. The Office action asserts that the interactive systems of Thonnart and Zaboklicki include “added program segment/fragment identifiers to transmitted program segments/fragments in order to have allowed the receiver station to find and identify those of the transmitted segments/fragments that it needs for its given user specific presentation.” This assertion is insufficient to demonstrate identifying content of both a first and a second media and controlling, based on identifying the content, a multimedia presentation.

The Office action points to no teaching from Zaboklicki or Thonnart where “program segment/fragment identifiers” are used to identify content of multiple media received on multiple receivers and controlling a multimedia presentation based on the identification. Zaboklicki fails to show or suggest multiple media received on multiple receivers. Thonnart discloses

transmission of a presentation of a series of pages of teletext, images, and audio commentaries arranged together in a fixed format by a composition device, 6, at a studio. Thonnart, col. 2, ll. 27-36, fig. 1. Thonnart discloses that the preset identifying messages are used to detect image and sound components of the presentation for transmission to memory. Thonnart col. 3, ll. 39-49. As acknowledged in the Office action, Thonnart includes no microcomputer for identifying content of multiple media and controlling, based on identifying content, a multimedia presentation. In Thonnart, the teletext, images, and audio commentaries are simply passed to memory to be reconstituted in the form composed at the studio. Thonnart discloses no apparatus equivalent to the microcomputer set forth in claim 76. There is no suggestion in Thonnart to control a multimedia presentation at the point of reception based on identifying content of multiple media. There is, therefore, no suggestion to modify Thonnart to include a microcomputer for controlling a multimedia presentation based on identifying content of multiple media.

There is no suggestion or motivation to modify Thonnart to include a microcomputer that identifies the content of multiple media and controls a multimedia presentation based on such identification. There is no showing or suggestion of such a microcomputer by Zaboklicki as asserted in the Office action. There is, therefore, no suggestion to modify Thonnart to include a microcomputer as suggested by the Examiner. For at least these reasons, the combination of Zaboklicki and Thonnart fails to show or suggest a microcomputer as set forth by claim 76.

**b. Claims 77-81**

Claims 77-81 depend from claim 76 and are referenced in Section E-25 of the Office action, which sets forth the rejection of claim 76. However, the additional limitations set forth by claims 77-81 are not addressed in Section E-25. Accordingly, the Office action fails to set forth a *prima facie* case of obviousness against these dependent claims. Claims 77-81 are patentable over Thonnart and Zaboklicki for at least the reasons set forth above with respect to claim 76.

Furthermore, claim 78 sets forth that the microcomputer controls storage of the first medium. Claim 78 depends from claim 77, which sets forth that the microcomputer controls storage of the information based on the second medium. Thonnart and Zaboklicki fail to show or suggest a microcomputer that controls storage of a first medium and storage of information from a second medium and controls a multimedia presentation comprising information included in the first medium and information based on the second medium.

Claim 79 sets forth that the first medium includes a television program including video and audio. Claim 79 depends from claim 76. As discussed above, claim 76 sets forth a microcomputer for identifying content of the first medium. Neither Zaboklicki or Thonnart shows or suggests identifying content of a first medium including a television program including video and audio.

**c. Claims 85-90**

Section E-26 rejects claims 85-90 as being unpatentable over Thonnart and Zaboklicki for the same reasons that were set forth for claims 76-81. No explanation is provided to support this rejection. Claim 85 is an independent apparatus claim. Claims 86-90 depend from claim 85. As the Office action fails to consider any of the limitations set forth by these claims, a *prima facie* case of obviousness has not been established.

Claim 85 sets forth a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of the series of discrete video images to be output. The Office action is wholly silent regarding where the applied art shows a microcomputer for creating a series of discrete video images based on processing a control signal. For at least the above reasons, the Office action fails to demonstrate that each element of claim 85 and claims 86-90 dependent therefrom are shown or suggested by Thonnart or Zaboklicki either singly or in any proper combination.

**7. Rejections Based On Zaboklicki, Field, Laviana And Soejima**

Claims 33, 34, 36, 95-97 and 99-102 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of Zaboklicki in view of U.S. Patent No. 4,398,216 to Robert W. Field et al. ("Field") and U.S. Patent No. 3,245,157 to Donald W. Laviana ("Laviana"). Claims 35 and 98 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the four reference combination of Zaboklicki in view of Field and Laviana for the same reason as set forth for claim 95, further in view of the publication "A Television Facsimile System" by Sueyoshi Soejima ("Soejima").

**a. Claim 95**

In Section E-27 of the Office action, claim 95 is rejected over Zaboklicki in view of Field and Laviana. Claim 95 sets forth a multimedia presentation apparatus. The apparatus presents a multimedia presentation of information included in a first signal received at first receiver at a first output device and information received in a second signal at a second output device. A microcomputer receives a user response and compares the response to information corresponding to content of the first signal in order to tune the second receiver to receive the second signal.

In the Office action, it is asserted that claim 95 differs from Zaboklicki in that circuit 43 of Zaboklicki does not explicitly show an audio tuner. Applicants assert that this is not the sole difference between claim 95 and Zaboklicki.

Zaboklicki fails to show or suggest a microcomputer for receiving a user response based on outputting a first signal, comparing the user response to information corresponding to content of the first signal, and based on the comparison tuning the second receiver to receive the second signal. The Office action asserts that elements 6, 7, 34, 39 and 49 of Zaboklicki inherently compare user entered responses to information of an interactive programming script. This assertion is insufficient to establish a *prima facie* case of obviousness.

As discussed above, the teaching of Zaboklicki is obscure. This obscure teaching includes no inherent teaching of a microcomputer that performs a comparison as set forth by

claim 95. In claim 95, a receiver receives a first signal and the microcomputer receives a user response based on outputting the first signal. The user response is compared to information corresponding to content of this first signal. The Examiner asserts that various components of Zaboklicki, the functions of which are not discussed, together form a microcomputer that inherently functions to compare user entered responses to information of an interactive programming script. It is unclear what the term “interactive programming script” refers to in the Office action. However, Zaboklicki shows no signal that is received and output that includes content to which a user response is compared.

Zaboklicki fails to show both a first receiver for receiving a first signal and a second receiver for receiving a second signal, where the first signal is output at a first output device and the second signal is output at a second output device. The Office action relies on receiver 54 to show all of these elements. There is simply no showing of multiple devices for outputting different received signals in Zaboklicki. The Office action relies on the “portion of TV receiver (54) . . . of Zaboklicki that receives the multi-channel TV signals” to show the first receiver. The CRT and speaker of the receiver 54 is relied upon to show first and second output devices. However, there is no suggestion in Zaboklicki that “multi-channel TV signals” are output by the CRT and not the speaker. The CRT and speaker of receiver 54 are not multiple independent output devices as suggested by Office action. Even if the speaker and CRT are considered to be independent output devices, there is no suggestion that the user response is based on outputting a first signal *at the CRT*. As discussed above, there is no suggestion that the user response is compared to information corresponding to content of the signal *output at the CRT*. Zaboklicki simply does not suggest first and second receivers as set forth by claim 95.

The secondary references to Field and Laviana fail to correct for the deficiencies of Zaboklicki as applied to claim 95 set forth above. The Office action relies on the secondary references to show tuning to an audio channel. However, even if it is assumed that Zaboklicki can be modified to tune to selected audio channels, Zaboklicki does not show every element of claim 95 for the reasons set forth above.

**b. Claims 96, 97, 99 And 100**

In Section E-28 of the Office action, claims 96, 97, 99 and 100 are rejected as being unpatentable over Zaboklicki in view of Field and Laviana for the same reasons that were set forth for claim 95. Claims 96, 97, 99 and 100 depend from claim 95. The Office action fails to present a *prima facie* case of obviousness against these claims. The Office action does not address any of the limitations set forth by these claims. The Office action merely states, “With respect to the claims 96 and 97, note figure 4 of Zaboklicki.” These claims are patentable over Zaboklicki in view of Field and Laviana for at least the reasons set forth above with respect to claim 95.

**c. Claims 33, 34, 36, 101 And 102**

Section E-29 rejects claims 33, 34, 36, 101 and 102 as being unpatentable over the three reference combination of Zaboklicki in view of Field and Laviana for the same reasons set forth for claims 96, 97, 99 and 100. There is no explanation provided setting forth any of the elements of a proper rejection under § 103 with respect to these claims. Accordingly, the Office action fails to establish a *prima facie* case of obviousness against these claims. Claim 33 sets forth a method that could be performed by the apparatus of claim 95. Claims 34, 36, 101 and 102 depend from claim 33. Zaboklicki fails to suggest all the elements of these claims for reasons similar to those set forth above with respect to claim 95. For example, Zaboklicki does not include sufficient details to suggest comparing a user response to information corresponding to content of a first signal as set forth in independent claim 33.

**d. Claims 35 And 98**

Section E-30 of the Office action rejects claim 98 as being unpatentable over the four reference combination of Zaboklicki in view of Field and Laviana for the same reason that was set forth for claim 95, further in view of Soejima. Claim 98 depends from claim 95 and sets forth that the second output device comprises a printer. Section E-31 of the Office action rejects claim 35 as being unpatentable over the four reference combination of Zaboklicki in view of

Field and Laviana for the same reason that was set forth for claim 33, further in view of Soejima. Claim 35 sets forth that the second signal is output at a printer. Soejima is relied upon to show transmission of a facsimile signal on the television sound signal.

There is no motivation in the cited art to combine the applied references in the manner suggested in the Office action. Laviana is applied to show tuning to alternate audio channels. Soejima is applied to show transmitting facsimile data in an audio channel. There is no suggestion in either reference to selectively tune an audio channel to receive text data. The reception of facsimile data is not compatible with the audio visual teaching system of Laviana. Soejima does not suggest the selective output of facsimile data with a presentation of television programming. The vagueness of the primary reference of Zaboklicki does not serve to salvage this rejection. A prime example of the non-enabling disclosure of Zaboklicki is the operation of printer 37. Zaboklicki includes a single sentence that notes that numeral 37 designates a printer. There is no further disclosure regarding the operation or function of the printer within the Zaboklicki system. There is simply no teaching in Zaboklicki regarding what the printer outputs. The numerous voids in the disclosure of Zaboklicki are not an invitation to the Examiner to use applicants' claims as a guide to attempt to explain how the Zaboklicki system may have functioned. None of the applied art suggests printing information from a second signal received based on a user response to content of a first signal. The only motivation to ascribe such a function to printer 37 is found in the applicants' specifications.

#### **8. Rejection Based On Tsuboka And Robinson**

Claims 2, 3, 5-8, 11-16, 20, 21-23, 37 and 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese patent publication 55-45248 naming Hidekazu Tsuboka et al. as inventors ("Tsuboka") in view of the article "'Touch-Tone' Teletext A Combined Teletext - Viewdata System" by Gary Robinson and William Loveless ("Robinson"). Tsuboka is directed to a character data receiving unit. Robinson proposes a teletext system in which a viewer can request a page over the telephone and receive the page over the air on a television set.

**a. Claim 2**

As discussed above, claim 2 sets forth that a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

The Office action asserts that claim 2 differs from the showing of Tsuboka only in that Tsuboka did not indicate a process in which the coordinated display of teletext/viewdata and video was produced based on a determined content of the TV programming. This is not the only difference between claim 2 and Tsuboka. For example, claim 2 sets forth outputting the multimedia presentation to a user based on the step of coordinating such that the presentation using the information from the first medium has a predetermined relationship to the content of the second medium. Tsuboka includes no suggestion to coordinate presentations to output a multimedia presentation such that any text data has a predetermined relationship to the content of any TV program.

There is no suggestion in Tsuboka of a step of determining content of a second medium. The Office action takes Official Notice that it was notoriously well known to those of ordinary skill in the art for conventional teletext services to have carried “program-related” teletext pages. The Examiner has taken similar Official Notice in the rejection based on Barnaby in view of Okada and Betts discussed above. The art referred to by the Examiner demonstrates that systems implementing “program-related” teletext pages were not well known, but rather were merely at the beginning stages of being considered. No details of such a system are provided in the cited art. The Office action, however, does not rely on this Official Notice in this rejection, rather, the rejection relies on Robinson. Applicants traverse the Official Notice to the extent that the Examiner seeks to establish details of distributing “program-related” teletext not disclosed by Robinson.

Robinson states, “Viewers could get the latest details on breaking stories or more detail on stories that interest them. News programs on television could refer a viewer to these pages to



get the detail that is cut out due to time limitations.” Robinson at 300. The Examiner asserts that in accessing such a page, the user inherently selected the program-related videotex page by determining content of the TV program medium. It is asserted, “the user determines that the content of the TV programming contains explicit reference to (i.e., an ‘identifier’ of) the program-related teletext page that was to be selected by the user.” There is no such teaching in Robinson. Robinson includes no teaching that news programs would include individual references to page identifiers of related content. The TV news program rather refers generically to the teletext system where additional detail is available. There is no teaching that the viewer uses an explicit reference to an identifier to access the material in the teletext system. Accordingly, there is no suggestion by Tsuboka or Robinson of a step of determining content as set forth by claim 2.

**b. Claims 3, 5-8 And 11-16**

Claims 3, 5-8 and 11-16 are rejected in Section E-33 of the Office action as being unpatentable over Tsuboka and Robinson for the same reasons that were set forth for claim 2. The Office action fails to address the limitations of these claims and, thus, the Office action fails to set forth a *prima facie* case of obviousness against these claims. As claims 3, 5-8 and 11-16 depend from claim 2, these claims include each limitation of claim 2 and are patentable over Tsuboka and Robinson for at least the reasons set above with respect to claim 2.

**c. Claim 20**

Section E-34 rejects claim 20 as being unpatentable over Tsuboka in view of Robinson. Claim 20 sets forth that a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium, whereby the content of the first and second media are identified.

Tsuboka and Robinson fail to suggest a step of receiving a first signal including an identifier. The Office action asserts that claim 20 is rejected for the same reason set forth for claim 2. As discussed above with respect to claim 2, the Office action erroneously asserts that

Robinson discloses a TV program having an identifier therein. There is no teaching in Robinson that any TV program includes an explicit reference to a particular program-related videotext image as asserted in the Office action.

Claim 20 further sets forth identifying content of the first medium based on the identifier. The Office action asserts that the user “processed the identifier to identify ‘content’ of the TV programming (i.e., the user processed the explicit reference contained therein to identify the page number of the program-related videotext page that is to be inputted/selected by the user.)” Neither Tsuboka nor Robinson suggest page numbers transmitted in TV programming as suggested by the Office action. Furthermore, there is no suggestion that any such page numbers would identify content of the TV programming as asserted in the Office action.

Claim 20 sets forth that information based on a second medium is generated based on identifying content of the second medium. The Office action fails to address this limitation. Tsuboka and Robinson fail to show or suggest such information.

**d. Claims 21-23**

Claims 21-23 are rejected in Section E-35 of the Office action as being unpatentable over Tsuboka and Robinson for the reasons set forth for claim 20. Claims 21-23 depend from claim 20. The Office action fails to address the limitations of these claims and, thus, fails to establish a *prima facie* case of obviousness against these claims. Tsuboka and Robinson fail to suggest each limitation of these claims for at least the reasons set forth above with respect to claim 20.

**e. Claims 37 And 67-69**

Claims 37 and 67-69 are rejected in Section E-35 of the Office action as being unpatentable over Tsuboka and Robinson for the reasons set forth for claim 20. The Office action fails to address the limitations of these claims and, thus, fails to establish a *prima facie* case of obviousness against these claims. Claim 37 is an apparatus claim that is generally analogous to method claim 2. Claims 67-69 depend from claim 37. Tsuboka and Robinson fail to show or suggest each limitation of claim 37 for the reasons set forth above with respect to

claim 2. Tsuboka and Robinson at least fail to suggest a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium based on determining content of the second medium. Claims 67-69 depending from claim 37 are also patentable over Tsuboka and Robinson for at least this reason.

#### **9. Rejection Based On Betts And "MODE II" Captioning**

Claims 2-8, 11-18, 37-41, 67-72 and 85-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over British patent specification 1 556 366 naming Betts as inventor in view of the "MODE II" captioning feature of the "ANTIOPE" teletext standard as discussed in: the article "Development & Applications of the Antiope-Didon Technology" by J. Guillermin ("Guillermin"); the "CBS/CCETT North American Broadcast Teletext Specification (Extended Antiope)" ("CBS/CCETT Spec."); and the article "Antiope Teletext Captioning" by Claude Sechet ("Sechet").

As an initial matter, applicants note that there is no indication in the cited art that MODE II captioning is prior art against applicants' claims. The Examiner, at pages 93-96 of the Office action, includes a summary of his understanding of MODE II captioning. This summary is also not itself prior art. The summary is also misleading. The Office action appears to rely on a description of MODE II caption from the CBS/CCETT Spec., which is subtitled "Extended Antiope." There is no suggestion in the cited art that MODE II captioning is part of the ANTIOPE standard. Accordingly, the Examiner has not shown that the "MODE II" captioning feature is included in the "ANTIOPE" teletext standard. The rejection based on the "MODE II" captioning feature of the "ANTIOPE" teletext standard is therefore improper as it does not rely on prior art.

With respect to the CBS/CCETT Spec., applicants submit that the Examiner has failed to establish that the reference qualifies as prior art to the claims of the instant application. The Examiner refers to this document as a "publication" in the Office action. However, the Examiner has not shown that the document was disseminated or otherwise made available to those of

ordinary skill in the art at a time that would render the document prior art to the claims of the instant application, in accordance with the requirements of M.P.E.P. Section 2128 and the Federal Circuit authorities cited therein. Although the document's cover page bears a date of May 20, 1981, no showing has been made that the document was disseminated or accessible by those of ordinary skill in the art by that date. Applicants acknowledge that the CBS/CCETT Spec. was the subject of testimony given in connection with an International Trade Commission investigation involving applicants' related issued patents (*In re Certain Digital Satellite Sys. (DSS) Receivers & Components Thereof*, No. 337-TA-392). However, that testimony also fails to establish when the document was disseminated or accessible (a copy of the transcript of the pertinent testimony is attached hereto at Tab A). Accordingly, applicants respectfully submit that all rejections based on the CBS/CCETT Spec. should be withdrawn, unless the Examiner can establish a publication date for the document that would qualify the reference as prior art. Applicants note, however, that the pending claims are in any event allowable over the various combinations of references that include the CBS/CCETT Spec. for the reasons set forth below.

The rejection purports to rely on the disclosure of Betts. The Office action, at pp. 96-97, asserts "that it would have been obvious to one of ordinary skill in the art to have utilized computer implemented teletext receivers/decoders, e.g. of the type described in Betts et al., for receiving and displaying conventional teletext data of the 'ANTIOPE' teletext standard including conventional 'Mode II' captioning provided therein." The Office action offers no explanation regarding how to modify the Betts device to be used in the "ANTIOPE" system. To the contrary, the Office action does not rely on the features disclosed in Betts whatsoever, rather, the Office action sets forth a list of "circuitry/software" the Examiner asserts would necessarily comprise such a computer. There is no showing where any of these features are actually shown in the prior art. For at least these reasons, the rejections based on Betts in view of "MODE II" captioning are improper and should be withdrawn.

**a. Claim 2**

Section E-36 of the Office action includes a rejection of claim 2 as being unpatentable over Betts in view of “MODE II” captioning. Claim 2 sets forth that a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

The Office action fails to demonstrate that any of the limitations of claim 2 are shown or suggested by actual prior art for the reasons set forth above. However, the statement that a computer implementing “MODE II” captioning would necessarily comprise “Circuitry/software for determining ‘content’ of a second medium received in said plurality of signals” is notably erroneous. The Office action asserts that “this limitation refers to nothing more than the detection of the ‘display control signal’ being that said display control signal at least represents the ‘content’ of the audio component of the TV programming to which the locally generated images/captions are to be synchronously displayed.” “Display control signals” do not identify content merely because they cause a graphic to be displayed with audio. In applicants’ specifications, for example, program identifiers are used to actually determine what television program is to be broadcast. Such identifiers can be used to determine the content of television programming. There is no suggestion that any “display control signals” or “reveal codes” of the MODE II captioning protocol include any such identifiers. No content of the audio component of the TV programming can be determined based upon a “display control signal” as suggested in the Office action.

**b. Claims 3-8 And 11-18**

Claims 3-8 and 11-18 are rejected as being unpatentable over Betts in view of the “MODE II” captioning feature for the same reasons set forth for claim 2. Claims 3-8 and 11-18 depend from claim 2. These rejections are improper for the reasons set forth above with respect to claim 2.

The Office action is particularly erroneous with respect to claims 7 and 8 for reasons similar to those set above with regard to claim 2. Claim 7 sets forth that the content of the second medium explains a significance of the presentation using the information from the first medium. Claim 8 depends from claim 7 and sets forth that the content of the second medium explains the significance in audio. The Office action, in section E-37, asserts that “the recited ‘content’ merely refers to the fact that the ‘display command signal’ of applicant’s ‘Wall Street Week’ embodiment arguably identified location of ‘content’ in the audio/video components of the TV programming with which the display of the ‘locally generated’ images are to be synchronized.” This statement is incorrect. Identifying a location within a program is not necessarily determining content of a program, as a location may be identified independently from any reference to content at the location. In applicants’ “Wall Street Week” embodiments, the audio of the TV program explains that the graphic using the stock quote information is the performance of the user’s portfolio. There is no suggestion that the audio or any other component of TV programming used with “MODE II” captioning explains the significance of any of the captions.

Claims 13 and 14 further define the step of determining. Claim 13 sets forth that the step of determining comprises processing an identifier. Claim 14 sets forth that the identifier identifies the content of the second medium. As discussed above with respect to claim 2, the “display control codes” relied upon in the Office action do not include identifiers that identify content of the TV program.

Claim 17 sets forth storing the second medium at the receiver station. The Examiner takes Official Notice that it was notoriously well known to include video recording devices at household receiving locations for recording broadcast TV programming for later playback. Applicants traverse this Official Notice to the extent that the Examiner is asserting that it was known to include video recording devices at any type of household receiver. The Examiner is relying on a proposed advanced teletext specification. There must be some suggestion in the

prior art that this advanced teletext specification is compatible with recording devices to establish a proper rejection under 35 U.S.C. § 103.

**c. Claims 37-41 And 67-69**

In Section E-38 of the Office action, claims 37-41 and 67-69 are rejected as being unpatentable over Betts in view of "MODE II" captioning for the same reasons that were set forth for claims 3-8, 11, 12, 17 and 18. Claim 37 is an apparatus claim that is generally analogous to method claim 2. Claims 38-41 and 67-69 depend from claim 37. The rejection of these claims based on Betts and "MODE II" captioning is improper for the reasons set forth above with respect to claims 2 and claims 3-8 and 11-18. Claim 37 sets forth a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium based on determining content of the second medium. The Office action fails at least to demonstrate that the prior art shows or suggests such a microcomputer.

**d. Claims 70-72**

In Section E-39 of the Office action, Claims 70-72 are rejected as being unpatentable over Betts in view of "MODE II" captioning for the same reasons that were set forth for claim 2. This rejection based on Betts in view of "MODE II" captioning is improper for the reasons set forth above.

Claim 70 sets forth a multimedia presentation apparatus including an output device for outputting a coordinated presentation of a first medium and information from a second medium; a receiver for receiving a plurality of signals including an identifier, the first medium and the second medium; and a microcomputer for identifying content of the first medium based on the identifier and executing processor instructions to enable the coordinated presentation of the first medium and information based on the second medium.

The Office action asserts that the identifier of claim 70 reads on the reveal/unmask code which identifies content of the TV programming. Similar to the rejection of claim 2, the Office

action merely asserts that the reveal/unmask code marks a specific location of the TV programming. However, the location of the reveal/unmask code does not identify content of the TV program (i.e., it does not identify the substance of the program). In applicants' disclosures, a program identifier is used to identify the content of the TV program. The Office action fails to demonstrate that the prior art suggests a microcomputer for identifying content of the first medium based on the identifier as set forth in claim 70.

Claim 71 and 72 depend from claim 70. The rejection of these dependant claims is improper for at least the reasons set forth above with respect to claim 70.

**e. Claims 85-90**

In Section E-40 of the Office action, claims 85-90 are rejected as being unpatentable over Betts in view of "MODE II" captioning for the same reasons that were set forth for claims 70-72. The rejection based on Betts in view of "MODE II" captioning is improper for the reasons set forth above. Claim 85 sets forth a multimedia presentation apparatus including a microcomputer for creating a series of discrete video images based on processing a control signal, identifying content of a first medium, and causing a video image of the discrete video images to be output. The apparatus also includes an output device at which the video image is combined into a multimedia presentation including the first medium.

The Office action fails to address the elements of claims 85-90 and thus fails to establish a *prima facie* case of obviousness against claims 85-90. The prior art fails to show or suggest at least a microcomputer for creating a series of discrete video images and identifying content of a first medium as set forth by claim 85.

**10. Rejection Based On Hedger, Gunn And Yoshino**

Claims 2, 3, 5-8 and 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of the publication entitled "Telesoftware: Home Computing Via Broadcast Teletext" by J. Hedger ("Hedger") in view of the publication entitled "A Public



Broadcaster's View of Teletext in the United States" by Hartford Gunn and Gregory W. Harper ("Gunn") and British patent 1 405 141 naming Hirokazu Yoshino et al. as inventor ("Yoshino").

Hedger is directed using the ORACLE teletext service as a source of broadcast software. Gunn is directed to possible uses for teletext systems in the United States. Yoshino, as discussed above, is directed to an electronic calculator that outputs a multiple row display in superposition with television.

**a. Claim 2**

In Section E-41 of the Office action, claim 2 is rejected as being unpatentable over Hedger in view of Gunn and Yoshino. In claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium. Specifically, claim 2 sets forth determining content of the second medium. Claim 2 also sets forth coordinating, at the receiver station under computer control, a presentation using the information with a presentation of the second medium based on the step of determining.

None of the cited references show or suggest a step of coordinating as set forth in claim 2. Hedger includes no suggestion to coordinate a presentation using broadcast software with a TV program. Gunn includes no suggestion to coordinate a presentation output by software with a TV program. The Office action asserts, "When executing telesoftware pertaining to 'program related' applications, it would have been obvious, in fact necessary, to have enabled the display device in Hedger's figure 1 to simultaneously display the computer generated video and the received 'Wall Street Week' TV programming." There is, however, no suggestion found in the cited references to have used the device of Hedger to display such program related applications. Gunn, relied upon to show "program-related" applications, also fails to teach a coordinated display. Gunn specifically states that the operation of "program-related" teletext assumes that the teletext decoder will be connected to the home computer. There is no suggestion in either

Hedger or Gunn to coordinate, at a receiver under computer control, a presentation based on two media.

The Office action further relies on Yoshino to show a coordinated display. There is no motivation found in the applied art to combine Hedger, Gunn and Yoshino. There is no suggestion in Yoshino of program-related software. There is no suggestion in Hedger or Gunn to coordinate software output with a TV program. Applicants' specification provides the only guide to combine these three references in the manner suggested in the Office action to result in "program-related" application output coordinated with TV programming. Absent applicants' specification, there is no motivation found in the cited art to combine the references in the manner suggested by the Office action.

Furthermore, the Office action asserts that the step of determining content is met by the user of the modified Hedger system receiving verbal instructions. However, the step of coordinating is at the receiver station under computer control and is also based on the step of determining. It is unclear how a step of coordinating is based on the user reception of verbal instructions. For example, the applied art fails to address how the system would handle or adjust to the myriad of different ways users may react to the instructions. More important, the applied art fails to suggest how the system would adjust to various reaction times of users or to non-compliance by users. These and many other problems are not addressed in the applied art as required to suggest a step of coordinating based on a step of determining performed by a user. It would not be obvious to one of ordinary skill in the art to combine the cited references in the manner suggested by the Office action, as the cited art addresses none of these issues.

**b. Claims 3, 5-8 And 11-18**

In Section E-42 of the Office action, claims 3, 5-8 and 11-18 are rejected as being unpatentable over Hedger in view of Gunn and Yoshino. Claims 3, 5-8 and 11-18 depend from claim 2 and thus include each limitation of claim 2. The Office action includes no attempt to address the limitations of claims 3, 5, 7, 8, and 13-16 and, thus, fails to set forth a *prima facie*

case of obviousness against these claims. Hedger, Gunn and Yoshino fail to show or suggest each limitation of claims 3, 5-8 and 11-18 for at least the reasons set forth above with respect to claim 2.

Claim 17 sets forth storing the second medium at the receiver station. The Examiner takes Official Notice that it was notoriously well known in the TV art to have included video recording devices at household receiving locations for recording broadcasted TV programming for later playback. However, there is no explanation how such a recording device would interact with “program-related” applications. Applicants traverse the Official Notice to the extent that the Examiner is asserting that it was known to record programming included in a coordinated presentation.

#### **11. Rejection Based On Hutt In View Of Betts**

Claims 2, 3-6, 5-8 and 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,961,137 to Peter Richard Hutt et al. (“Hutt”) in view of Betts. Hutt is directed to a television system in which data is transmitted in the blanking intervals of the video signal.

Claim 2 sets forth that a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium. Claim 2 sets forth a step of determining content of the second medium. The Office action asserts that Hutt includes “[c]ircuitry for detecting [i.e., thereby ‘determining’] the sync signal ‘content’ of the video-type media.” As discussed in Section F above, detecting sync signals is not determining content of a medium. Detecting sync signals does not determine the substance of the video medium. Hutt fails to show a step of determining content of a second medium as set forth by claim 2.

Claim 2 further sets forth coordinating, at a receiver station under computer control, a presentation using the information from the first medium with a presentation of the second

medium based on the step of determining. The presentation using the information has a predetermined relationship to the content of the second medium. There is no suggestion in Hutt that the presentation of the text is coordinated with the display of the TV programming such that the text has a predetermined relationship to the content of the TV programming.

The secondary reference to Betts corrects none of these deficiencies of Hutt. The Office action acknowledges that the receiver station of Hutt is not under computer control. Betts is relied upon to show computer control of a receiver station. There is no suggestion in Betts of a computer that controls a receiver station to determine content of any medium or to coordinate a presentation such that information from a first medium has predetermined relationship to content of a second medium. There is no motivation found in the applied art to modify Hutt to include any such computer.

**a. Claims 3-6, 11-14 And 18**

In Section E-44 of the Office action, claims 3-6, 11-14 and 18 are rejected as being unpatentable over Hutt in view of Betts for the same reason that was set forth for claim 2. Claims 3-6, 11-14 and 18 depend from claim 2 and, thus, include each limitation of claim 2. Hutt in view of Betts fails to show or suggest each limitation of these claims for at least the reasons set forth above with respect to claim 2. The Office action is silent regarding the limitations set forth in claims 3-5, 11 and 12, and, thus, fails to establish a *prima facie* case of obviousness against these claims.

Claims 13 and 14 define further aspects of the step of determining absent from the applied art. Claim 13 sets forth that the step of determining comprises processing an identifier. Claim 14 depends from claim 13 and sets forth that the identifier identifies the content of the second medium. In the Office action, it is asserted that the sync signal components of a video signal are “identifiers” which identify the specific sync/timing content of the video signal. This assertion is erroneous and highlights the flaws in the Examiner reasoning. The timing of the video signal is independent the content of the television program. The sync signals are not

identifiers that identify the content of the television program as they are the same for every television transmission.

## **12. Rejection Based On Fujino**

In Sections E45-46, the Examiner rejects claims 2, 3, 4, 7, 10, 13-15, and 17 under § 103(a) as being unpatentable over U.S. Patent No. 4,675,737 to Fujino et al. ("Fujino"). Applicants respectfully submit that: (1) Fujino is not an available reference due to applicants' asserted priority date, and (2) claims 2, 3, 4, 7, 10, 13-15, and 17 are patentable over Fujino.

### **a. Fujino Is Unavailable Based On Applicants' Asserted Priority Date**

Applicants maintain that claims 2, 3, 4, 7, 10, 13-15, and 17 are entitled to the benefit of the November 3, 1981 filing date of applicants' patent application no. 317,510. As applicants' asserted priority date predates the effective filing date of Fujino, applicants respectively submit that Fujino does not qualify as an available prior art reference. In the Prior Office action, the Examiner asserted that none of applicants' then-pending claims were entitled to a 1981 priority date under § 120. In response, applicants submitted an expert declaration in accordance with 37 C.F.R. § 1.132 demonstrating that:

the claimed subject matter of amended claim 2 is disclosed in sufficient detail, in both the 1981 and 1987 specifications, that a person of ordinary skill in the relevant time frames would reasonably understand that the inventor possessed the subject matter of amended claim 2 at the time of filing those specifications.

Ligler Declaration, p. 10. The Ligler Declaration also states that all claims depending from claim 2 are similarly disclosed in both the 1981 and 1987 specifications in such a way as to demonstrate to one of ordinary skill in the relevant art that the inventor was in possession of the claimed subject matter at the time each specification was filed. Ligler Declaration, p. 7.

While the Examiner relies upon Fujino in the Office action, he does not challenge the conclusions set forth in the Ligler Declaration or applicants' assertion in their January 2003

Response that claims 2, 3, 4, 7, 10, 13-15 and 17 are entitled to the benefit of the 1981 filing date of the 1981 specification. Instead, in Section E of the Office action, the Examiner only states that:

it is unclear from [applicants' and applicants' expert's] arguments what "standard" of proof applicants and applicants' expert have adopted in support of their conclusions.

Office action, p. 56. Applicants note that the Ligler Declaration makes clear that Dr. Ligler

reviewed the standards set forth in Sections 201.11 and 2163 of the Manual of Patent Examining Procedures (MPEP) (8<sup>th</sup> Ed. 2001) in conjunction with 35 U.S.C. §§ 112 and 120 and [] applied the standards set forth in those documents to perform [his] analysis of the written description issue . . .

Ligler Declaration, p. 4. Further, in their January 2003 Response, applicants clearly set forth the proper standards applicable to the requirements of § § 112 and 120. For example, applicants cited the following case to describe the appropriate standard under § 120:

A claim in a CIP [continuation-in-part] application is entitled to the filing date of the parent application when the claimed invention is described in the parent specification in a manner that satisfies, inter alia, the description requirement of 35 U.S.C. § 112.

*Therma-Tru Corp. v. Peachtree Doors Inc.*, 44 F.3d 988, 992, 33 U.S.P.Q.2d 1274, 1276 (Fed. Cir. 1995).

Applicants also cited another Federal Circuit decision setting forth the appropriate standard under the written description requirement of § 112, first paragraph:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

*In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983).

Applicants succinctly summarized their understanding regarding the proper standards applicable to §§ 112 and 120:

The proper legal standard for satisfying § 120, as articulated on many occasions by the Federal Circuit, is that the claimed invention must be described in the parent application in a manner that satisfies the terms of § 112.

\* \* \*

The crucial issue for determining if a claim is entitled to the filing date of an earlier application is whether the earlier application shows that the inventor was in possession of the claimed invention as of the date sought under § 120.

January 2003 Response, pp. 24-25.

Notwithstanding the above-quoted passages and other discussions of the proper standards for §§ 112 and 120, the Examiner alleges that applicants “have confused the issue of ‘support’ required by § 112 (as incorporated into section 120) with the issue of ‘anticipation’ that exists under § 102.” Contrary to the Examiner’s assertion, applicants have never confused or otherwise described the standard for determining whether or not the written description requirement of § 112, first paragraph, is met in terms of an “anticipation” standard. As stated by applicants on numerous occasions, the standard applicants apply for meeting the written description requirement is the standard clearly articulated by the Federal Circuit:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

*In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983). As discussed above, this is also the same standard or test applied by Dr. Ligler in his declaration. *See* Ligler Declaration, p. 10.

For the reasons set forth in applicants’ instant Response and applicants’ January 2003 Response, as well as the reasons set forth in the Ligler Declaration, applicants maintain that claims 2, 3, 4, 7, 10, 13-15 and 17 are entitled to the benefit of the filing date of the 1981 specification. The Examiner has not explained how or why applicants’ showing that claims 2, 3, 4, 7, 10, 13-15 and 17 are entitled to the benefit of the filing date of the 1981 specification is in

any way deficient. *See, e.g.*, MPEP § 2163.04 (“When a rejection [under § 112, first paragraph] is maintained, any affidavits relevant to the 35 U.S.C. 112, para. 1, written description requirement, must be thoroughly analyzed and discussed in the next Office action.”).

Accordingly, Fujino is not available as a prior art reference.

In any event, Fujino fails to render claims 2, 3, 4, 7, 10, 13-15 and 17 unpatentable under § 103(a). Fujino describes an apparatus used to superimpose the text from a character signal over video from a video signal. Fujino discloses an apparatus for reproducing (i.e., playing) a video disc and a superimposing apparatus which generates a character signal from a ROM cartridge supplied to the superimposing apparatus. The superimposing apparatus generates a character signal (representing, e.g., close captioning text in a particular language) corresponding to positional information included in the video signal. Thus, the superimposing apparatus of Fujino utilizes a standard video disc manufactured for use in various geographic locations with an appropriate ROM cartridge containing foreign language character data corresponding to the video dialogue. The Examiner asserts that Fujino only fails to disclose the “computer” recited in claims 2, 3, 4, 7, 10, 13-15 and 17, and the Examiner indicates that he takes Official Notice that it was well known that software driven computers could be used in place of dedicated hardware when implementing signal processing circuitry.

Fujino, however, fails to teach or disclose “receiving said plurality of signals, at least a portion of said plurality of signals being received from a source external to said receiver station, said plurality of signals including at least two media.” The Examiner asserts that Fujino discloses a “video reproducing apparatus (e.g., 1 of Figure 1) which receives a first signal representing an encoded video signal “media,” wherein the first signal is received from an external source via a first recording medium (e.g., via a video disc).” Office action p. 107. The Examiner relies on the video signal from the video disc as the source of the “first signal.” The video disc/signal, however, is integral to the receiver station and is not received from an external source.



Fujino also fails to teach or disclose “determining content of a second medium received in said plurality of signals” and the recited “coordinating” based on the step of determining. The Examiner asserts that the “sync separator 12 of figure 2 which detects (and thereby ‘determines’) a data signal content of the video signal ‘media’” or the “[d]ata detection circuitry (e.g. 13, 20, 22, of figure 2) which detects (and thereby ‘determines’) a data signal content of the video signal ‘media’ ” discloses determining the content of a second medium. As discussed in Section F above, the mere detection of video sync signals fails to suggest determining content of the television program. The data detection circuitry of Fujino does not suggest determining content of a second medium. First, mere detection of a data signal does not necessarily determine the content of the data. The combination of elements of Fujino relied upon to show data detection circuitry -- comparator 13, shift register 20, and comparator 22 -- are used to extract positional data from the video signal. Fujino col. 4, l. 41 - col. 5, l. 2. This positional data does not represent the substance of any video or character data. Accordingly, the detection of this positional data is not determining content of the video signal as asserted in the Office action.

### **13. Rejection Based On “MODE II” Captioning And Teletext**

Claims 2-8, 11-18, 20-23, 37-41, 67-72 and 85-90 stand “rejected under 35 U.S.C. 103(a) as being unpatentable over the notoriously well known ‘Mode II’ captioning feature of a conventional ANTIOPE teletext data service (as discussed in paragraph D-2 of this Office action) in view of the notoriously well known computer driven Teletext decoder structure (as discussed in paragraph C-4 of this Office action).” This rejection is improper. The rejection makes no attempt whatsoever to set forth “the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate.” M.P.E.P. § 706.02(j). The rejection makes no reference to any prior art, but rather relies on sections of the Office action written by the Examiner specifically to provide a basis for rejecting applicants’ claims. “Where a reference is relied upon to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the

rejection.” *Id.* (citing *In re Hoch*, 428 F.2d 1341, 1342 n. 3, 166 U.S.P.Q. 406, 407 n. 3 (C.C.P.A. 1970)). As these rejections are based on no specifically identifiable prior art references, they should be withdrawn.

The Examiner mischaracterizes “MODE II” captioning as a feature of ANTIOPE teletext. The Office action cites no references that show that any operating ANTIOPE system included “MODE II” captioning. Accordingly, the Examiner has not demonstrated that “MODE II” captioning itself is prior art.

In both paragraphs C-4 and D-2, which serve as the basis of this rejection, the Examiner alleges that features found in a collection of references make up “well known” systems. The Examiner now attempts to apply the combination of features that he has assembled and labeled “well known” against applicants’ claims. If the combination of these features are truly notoriously well known, it should not be difficult for the Examiner to set forth in the rejection where in the prior art the features are found and to set forth a proper motivation for combining whatever references are relied upon. Without such a showing, the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, the Examiner’s description of “MODE II” captioning fails to render applicants claims obvious for the following reasons.

With respect to claim 2, the Office action at least fails to set forth any suggestion of a step of determining content of a second medium. The Office action asserts that a teletext decoder for receiving “MODE II” captioning must necessarily “[d]ecode subsequent ones of the extracted packets to detect the described ‘reveal’ command which corresponds to the class of the user selected captioning (corresponding to the recited step of “determining content”).” There is no explanation how a reveal code that indicates the class of captioning is used to determine content of a second medium (such as the television program).

With respect to claim 14, the Office action fails to suggest that the step of determining comprises processing an identifier that identifies the content of the second medium. The Office action asserts that “reveal” codes identify a time in the TV programming at which the program

related captions are to be displayed. The Office action fails to allege that the reveal codes identify content of the television program. As asserted by the Office action, the reveal codes merely indicate when captioning should be displayed; there is no assertion that the reveal codes indicate what information content is included in the TV program at the time.

The Office action asserts in section E-49 that claims 20-23, 37-41, 67-72 and 85-90 are rejected for the same reasons that were set forth for claims 3-8 and 11-18. The particular limitations of these claims are not addressed in the Office action. These rejections should be withdrawn as none of the requirements of a proper rejection under 35 U.S.C. § 103 have been presented in the Office action.

#### **14. Rejection Based On Marti And The CBS/CCETT Spec.**

Claims 2, 3-8, 11-18, 20-23, 37-41, 67-72, 85-90 stand rejected “under 35 U.S.C. § 103(a) as being unpatentable over the publication ‘The Concept of a Universal “Teletext” (broadcast and interactive Videotex) Decoder Microcomputer based’ by Marti in view the notoriously well known Mode II Captioning feature of the ANTIOPE teletext standard as described in the 1981 ‘CBS/CCETT NORTH AMERICAN BROADCAST TELETEXT SPECIFICATION (EXTENDED ANTIOPE)’ publication.” The Examiner takes Official Notice that the “MODE II” captioning feature of the ANTIOPE videotext specification was notoriously well known in the art at the time of applicants’ invention. The Examiner cites to the CBS/CCETT Spec. as evidence. Applicants traverse this Official Notice. The CBS/CCETT Spec. speaks for itself. There is no evidence that the specifics of the CBS/CCETT Spec. were “notoriously well known” prior to applicants’ invention. In fact as discussed in Section 9 above, the Examiner has failed to establish that the CBS/CCETT Spec. qualifies as prior art to the claims of the instant application.

Marti is directed to the development of a decoder that may receive multiple forms of data from various services. Marti in view of the CBS/CCETT Spec. fails to show or suggest each element of any of applicants’ claims.

**a. Claim 2**

In Section E-50 of the Office action, a rejection of claim 2 based on Marti and the CBS/CCETT Spec. is presented. The rejection merely asserts an interpretation of the relevant teachings of the cited art. The rejection fails to address the steps of claim 2. The rejection fails to set forth the differences in the claims over the cited references, proposed modification to the cited references, or any explanation of a motivation to combine the teachings of the cited references. For this reason this rejection of claim 2 is improper and should be withdrawn.

In claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium. There is no showing in the Office action how the cited references show or suggest any of these steps of claim 2. Significantly, claim 2 also sets forth a step of determining content of a second medium. The cited art fails to show or suggest such a step of determining.

**b. Claims 3-8 And 11-18**

In Section E-51 of the Office action, claims 3-8 and 11-18 are rejected based on Marti and the CBS/CCETT Spec. for the same reason that was set forth for claim 2. Claims 3-8 and 11-18 depend from claim 2. These claims are patentable over Marti and the CBS/CCETT Spec. for at least the reasons set forth above with respect to claim 2. The rejections set forth in Section E-51 of the Office action are identical to the rejections set forth in section E-48 of the Office action which is also based on "MODE II" captioning. These rejections are improper as set forth in Section 13 above.

**15. Claims 20-23, 37-41, 67-72 And 85-90**

In Section E-52 of the Office action, claims 20-23, 37-41, 67-72 and 85-90 are rejected based on Marti and the CBS/CCETT Spec. for the same reason that was set forth for claims 3-8

and 11-18. The Office action fails to address the limitations of these claims and thus fails to establish a *prima facie* case of obviousness against these claims. Applicants assert that the

Claim 20 sets forth that a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium, whereby the content of the first and second media are identified. The cited prior art does not suggest at least the step of identifying content of a first medium based on an identifier as set forth in claim 20. Claim 70 is an apparatus claim that is generally analogous to claim 20. The cited prior art does not suggest at least a microcomputer for identifying content of a first medium based on an identifier as set forth in claim 70. Claims 21-23 depend from claim 20 and are patentable over Marti and the CBS/CCETT Spec. for at least the above reasons. Claims 71 and 72 depend from claim 70 and likewise are patentable over Marti and the CBS/CCETT Spec. for at least the above reasons.

Claim 37 is an apparatus claim that is generally analogous to method claim 2. The cited prior art fails to show or suggest each element of claim 37 for the reasons set forth above with respect to claim 2. Marti and the CBS/CCETT Spec. fail to set forth at least a microcomputer that coordinates a presentation using information from a first medium with a presentation of a received second medium based on determining content of the second medium as set forth by claim 37. Claims 38-41 and 67-69 depend from claim 37. These claims are patentable over Marti and the CBS/CCETT Spec. for at least the above reasons.

Claim 85 sets forth a multimedia presentation apparatus. The apparatus includes a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of said series of discrete video images to be output. Marti and the CBS/CCETT Spec. do not show or suggest such a microcomputer. The Office action does assert "In MODE II captioning, each the 'reveal' codes represent [sic] a 'control signal' which identifies content of the first TV signal medium (e.g. a timing content, an audio content, etc, . . . )." This statement is unclear. The CBS/CCETT Spec. does not suggest that the reveal codes identify audio content of the TV program. The timing of the reveal code does not identify any content of the TV program.

Claims 86-90 depend from claim 85. These dependant claims are patentable over Marti and the CBS/CCETT Spec. for at least the reasons set forth above.

### **I. Response To Double Patenting Rejection**

In Section E53-54, the Examiner rejects claims 2-18, 20-30, 33-42, and 67-104 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 4,694,490 (the “‘490 patent”). The ‘490 patent and the instant application share common inventors.

In determining whether obviousness-type double patenting exists the relevant inquiry is whether the claim or claims pending in the current application define an invention that is merely an obvious variation of an invention claimed the issued patent. M.P.E.P. § 804. A rejection based on obviousness-type double patenting must demonstrate that the claimed subject matter is not patentably distinct from the subject matter claimed in the issued patent. *See In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985). The M.P.E.P. instructs examiners to employ the *Graham* factors, *see Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), used to establish a case of obviousness when making an obviousness-type double patenting analysis. M.P.E.P. § 804. Further, the M.P.E.P. instructs examiners that:

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

M.P.E.P. § 804; *see also In re Kaplan*, 789 F.2d 1574, 229 U.S.P.Q. 1574 (Fed. Cir. 1986) (to support an obviousness-type double patenting rejection “there must be some clear evidence to establish why the variation would have been obvious”).

The Examiner's obviousness-type double patenting rejection fails to discuss any *Graham* factors and fails to identify any differences between the pending claims and the claims in the '490 patent and the reasons why a person of ordinary skill in the art would conclude that the inventions defined in the pending claims are merely obvious variations of the inventions claimed in the claims of the '490 patent. Accordingly, the Examiner has not made out a *prima facie* case of obviousness-type double patenting.

The Examiner's double patenting rejection essentially consists of an assertion that the instant claims and claims 1-13 of the '490 patent define obvious variants of the same invention because they rely on the same written description support in applicants' 1981 specification (i.e., the Wall Street Week example). Without any analysis whatsoever, the Examiner lists the written description support from the 1981 specification identified by applicants and asserts that when such support is identified:

it is becomes [sic] apparent that the instant claims have simply adopted different language to recite/describe the same receiver side "Wall Street Week" overlay method/processing that has already been covered/recited via claims 1-13 of [the '490 patent] . . . .

Office action, p. 118. Notwithstanding the fact that the Examiner's assertions fail to make out a *prima facie* case of obviousness-type double patenting, the Examiner's position is untenable because he improperly reads functions not actually recited into claims 1-13 of the '490 patent.

The Examiner merely asserts that the "Wall Street Week" disclosure in the 1981 specification supports claims 2-18<sup>4</sup> and is "covered/recited via claims 1-13" of the '490 patent. The Examiner's exclusive reliance on the disclosure of the patent instead of the scope and content of the patent claims is improper.

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<sup>4</sup> Applicants acknowledge that the description regarding "Wall Street Week" in the 1981 specification provides support meeting the requirements of 35 U.S.C. § 112, first paragraph. To the extent that the Examiner's summary of this support in Section E-53 of the Office action is meant to correspond to the support set forth in the January 2003 Response, particularly the Ligler Declaration attached as Exhibit II, the summary is not entirely accurate. For example, the Examiner states, "The section 112 support for the recited 'determination' of 'content' of the 'second medium' of the instant claims is nothing more than the detection of the 'graphics-on' instruction signal." However, Dr. Ligler states, "[A] program identifier received in advance of the exemplary Wall Street Week broadcast is used to determine content of the Wall Street Week television program."

The M.P.E.P. cautions examiners from doing precisely what the Examiner has done in Section E-53 of the Office action. The M.P.E.P. instructs examiners that in determining whether a pending claim defines an invention that is an obvious variation of an invention claimed in an issued patent, the specification of the issued patent cannot be used as prior art. M.P.E.P. § 804. The obviousness analysis is limited solely to *inventions defined by the* claims. Of course, in determining whether the claimed invention is an obvious variant of that defined by the issued claim, relevant portions of the specification can be used to ascertain the scope and meaning of an issued claim. *See In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970). It is, however, improper to read limitations from the specification into the claims of the issued patent. *See e.g.*, Donner, Irah H., *Patent Prosecution: Practice & Procedure Before the U.S. Patent Office*, Ch.10.VIII.B.1 (2nd ed. 1999) (discussing *In re Vogel* and noting “[t]hus whereas the patent disclosure may be used to interpret claims, the Examiner may not read the specification into the claims in an effort to buttress a double-patenting rejection”).

There is simply nothing to bar the allowance of later claims supported by a disclosed embodiment that is “covered” by previously issued claims provided that the later claims define an invention that is not merely an obvious variation of an the invention claimed in the issued patent. The pending claims of the instant application contain numerous steps and other limitations which are not found or suggested in claims 1-13 of the ‘490 patent. For example, at a minimum, none of claims 1-13 of the ‘490 patent include steps directed to determining or identifying content of a first or second medium. Accordingly, applicants respectfully request that the Examiner withdraw the obviousness-type double patenting rejection of the pending claims.

In Section E-54 of the Office action, claims 20-30, 33-42 and 67-104 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of the ‘490 patent for the same reasons that were set forth for claims 2-18. The Examiner fails to address the limitations of these claims and thus fails to set forth a *prima facie* case of obviousness-type double patenting against these claims. Furthermore, the Examiner’s

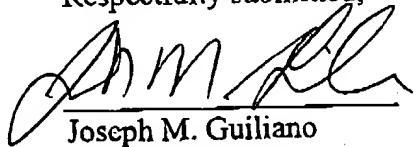


improper rejection of claims 2-18 is based on Dr. Ligler's use of disclosure regarding "Wall Street Week" to demonstrate support for claims 2-18. Applicants note that Dr. Ligler cites to disclosure regarding a cooking show to demonstrate support for claims 24, 25, 33-36, 74, 75 and 95-104. Accordingly, the double patenting rejection as presented against claims 2-18 is not applicable to claims 24, 25, 33-36, 74, 75 and 95-104.

### III. CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Reconsideration and allowance of the instant application are respectfully requested.

Respectfully submitted,



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